



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In re Application of:**

Goulmy et al.

**Serial No.:** 09/489,760

**Filed:** January 21, 2000

**For:** THE HA-1 ANTIGEN

**Confirmation No.:** 6225

**Examiner:** P. Huynh

**Group Art Unit:** 1644

**Attorney Docket No.:** 2183-4285US

**NOTICE OF EXPRESS MAILING**

Express Mail Mailing Label Number: EV 326919482US

Date of Deposit with USPS: February 5, 2004

Person making Deposit: Christopher Haughton

**PETITION FOR A RETROACTIVE LICENSE  
UNDER 35 U.S.C. § 184**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The applicants hereby petition for a retroactive license under 35 U.S.C. § 184 in accordance with 37 C.F.R. § 5.14(a) for the referenced US application.

02/10/2004 MGE BREH1 00000192 201469 09489760

01 FC:1460 130.00 DA

The applicants request retroactive foreign filing licenses for the following applications:

Foreign Country	Filing Date	Application Number (Patent Number)
European Patent Office	July 23, 1997	EP 97202303.0
Netherlands	July 23, 1998	PCT/NL98/00424
Japan	July 23, 1998	JP19982000504165 (JP2001510851T2)
European: Austria, Belgium, Switzerland, Germany, Denmark, Spain, France, United Kingdom, Greece, Ireland, Italy, Liechtenstein, Luxembourg, Monaco, Netherlands, Portugal, and Sweden	July 23, 1998	EP1998000936758 (EP0996636)
Australia	July 23, 1998	AU1998199885640 (AU8564098A1)
Australia	July 23, 1998	AU1998199885639 (AU8563998A1)
Australia	July 23, 1998	AU1998000085639 (AU0756962B2)

The first filing is the priority document, EP 97202303.0, filed July 23, 1997, now abandoned. Within one year of the priority document an international PCT application was filed, PCT/NL98/00424, filed July 23, 1998, designating all of the member states and regional offices. The Japanese, European and Australian patents referenced herein represent national entries of the PCT application.

A declaration by Dr. Victor H. Engelhard is attached herewith, avering to diligence in obtaining the retroactive foreign filing license. A declaration by Dr. Donald F. Hunt will be

submitted as soon as it becomes available.

Pursuant to 37 C.F.R. § 5.25(a)(3)(ii) and (iii), the foreign filing of the priority document and the international PCT application, as well as the national entries effected from the international filing, were prepared and filed by the Assignee, Rijksuniversiteit te Leiden, a University in the Netherlands, through European counsel, who were unfamiliar with US Patent Law and the requirement of a foreign filing license. Therefore, until the international application entered the United States Patent and Trademark Office (USPTO), there was no knowledge of the pertinent law and facts (Patent Office Rules and Practice Rule 1.14, section VII) (copy attached). Thus, the possible need for a foreign filing license did not become apparent until at least the entry of the application into the USPTO (*In re Application* filed November 22, 1952, 837 O.G. 1046, 153 U.S.P.Q. 410 (Comm'r Pat. and Trademarks 1967)), which explains why the material was filed abroad (in the Assignee's and an inventor's home country) through error and without deceptive intent, without the required license (37 C.F.R. § 5.25 (a)(3)(iii)).

It is submitted that diligence in obtaining a retroactive foreign filing license is shown by the present Petition for a Retroactive License concurrently with the payment of the issue fee and prior to issuance of a patent. Furthermore, negotiations involving issues surrounding ownership of the invention were ongoing since filing of the application. The ownership issue evidently precluded or hindered the ability to determine if a foreign filing license was in fact required and the proper parties for such a license. In particular, if the parties from the US were not co-inventors, then no foreign filing license would be necessary.

As indicated in the attached declaration, the potential need for a retroactive foreign filing license and a declaration was inadvertently not communicated to the inventors. Upon learning of the possible need for a foreign filing license, the inventor, Dr. Victor H. Engelhard, diligently executed the attached declaration.

Pursuant to 37 C.F.R. § 5.25(a)(3)(ii), the present petition for a retroactive filing license is being filed concurrently with the payment of the issue fee. Thus, the resolution of the foreign filing license is being sought before the grant of a U.S. Patent "in order that the status of the patent may be known with certainty" (Patent Office Rules and Practice Rule 14, section V, citing *Beckman Instruments, Inc. v. Coleman Instruments, Inc.*, 143 USPQ 278 (7th Cir. 1964)).

**Serial No. 09/489,760**

Applicants submit that under the circumstances of the present case, for example, resolution of ownership and inventorship, as well as, prosecution by the assignee, the Rijksuniversiteit te Leiden, through European associates, diligence has been pursued in obtaining a retroactive foreign filing license.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'G. Scott Dorland', written in a cursive style.

G. Scott Dorland, Ph.D.

Registration No. 51,622

Attorney for Applicants

TRASKBRITT, P.C.

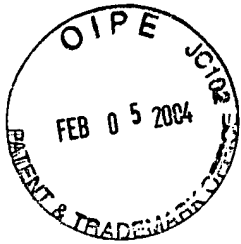
P.O. Box 2550

Salt Lake City, Utah 84110-2550

Telephone: 801-532-1922

Date: February 5, 2004

GSD/gsd



## LEXSTAT 1-I PATENT OFFICE RULES AND PRACTICE RULE 14

Patent Office Rules and Practice  
Copyright 2003, Matthew Bender & Company, Inc., a member of the LexisNexis Group.

### Chapter I THE PATENT OFFICE

#### PATENT AND TRADEMARK OFFICE LICENSES FOR FOREIGN FILING

##### *1-I Patent Office Rules and Practice Rule 14*

#### **Rule 14 Patent applications preserved in secrecy**

##### **§ 1.14 Patent applications preserved in secrecy.**

[reserved]

(a) Except as provided in § 1.11(b) pending patent applications are preserved in secrecy. No information will be given by the Office respecting the filing by any particular person of an application for a patent, the pendency of any particular case before it, or the subject matter of any particular application, nor will access be given to or copies furnished of any pending application or papers relating thereto, without written authority in that particular application from the applicant, or his assignee or attorney or agent of record, unless the application has been identified by serial number in a published patent document or the United States of America has been indicated as a Designated State in a published international application, in which case status information such as whether it is pending, abandoned or patented may be supplied, or unless it shall be necessary to the proper conduct of business before the Office or as provided by this part. Where an application has been patented, the patent number and issue date may also be supplied.

(b) Except as provided in § 1.11(b) abandoned applications are likewise not open to public inspection, except that if an application referred to in a U.S. patent, or in an application in which the applicant has filed an authorization to open the complete application to the public, is abandoned and is available, it may be inspected or copies obtained by any person on written request, without notice to the applicant. Complete applications (§ 1.51(a)) which are abandoned may be destroyed after 20 years from their filing date, except those to which particular attention has been called and which have been marked for preservation. Abandoned applications will not be returned.

(c) Applications for patents which disclose or which appear to disclose, or which purport to disclose, inventions or discoveries relating to atomic energy are reported to the Department of Energy, which Department will be given access to such applications, but such reporting does not constitute a determination that the subject matter of each application so reported is in fact useful or an invention or discovery or that such application in fact discloses subject matter in categories specified by Sections 151(c) and 151(d) of the Atomic Energy Act of 1954, 68 Stat. 919; 42 U.S.C. 2181(c) and (d).n1

(d) Any decision of the Board of Patent Appeals and Interferences, or any decision of the Commissioner on petition, not otherwise open to public inspection shall be published or made available for public inspection if:

(1) The Commissioner believes the decision involves an interpretation of patent laws or regulations that would be of important precedent value; and

(2) the applicant, or any party involved in the interference, does not within one month after being notified of the intention to make the decision public, object in writing on the ground that the decision discloses a trade secret or other confidential information. If a decision discloses such information, the applicant or party shall identify the deletions in the text of the decision considered necessary to protect the information. If it is considered the entire decision must be withheld from the public to protect such information, the applicant or party must explain why. Applicants or parties will

## Patent Office Rules and Practice Rule 14

be given time, not less than twenty days, to request reconsideration and seek court review before any portions of decisions are made public over their objection. See § 2.27 for trademark applications.

(e) Any request by a member of the public seeking access to, or copies of, any pending or abandoned application preserved in secrecy pursuant to paragraphs (a) and (b) of this section, or any papers relating thereto, must

(1) Be in the form of a petition and be accompanied by the petition fee set forth in § 1.17(i), or

(2) Include written authority granting access to the member of the public in that particular application from the applicant or the applicant's assignee or attorney or agent of record.

**Note:** See § 1.612(a) for access by an interference party to a pending or abandoned application.

(Pub. L. 94-131, 89 Stat. 685; 35 U.S.C. 6, Pub. L. 97-247; 15 U.S.C. 1113, 1123)

### Legislative History

[24 Fed. Reg. 10332, Dec. 22, 1959; 42 Fed. Reg. 5593, Jan. 28, 1977; 43 Fed. Reg. 20462, May 11, 1978; 47 Fed. Reg. 33086, Jul. 30, 1982; 47 Fed. Reg. 41273, Sept. 17, 1982; 49 Fed. Reg. 548, Jan. 4, 1983, effective Apr. 1, 1984; 49 Fed. Reg. 48451, Dec. 12, 1984, effective Feb. 11, 1985; 50 Fed. Reg. 9378-79, Mar. 7, 1985; 53 Fed. Reg. 23733-34, Jun. 23, 1988, effective Sept. 12, 1988; 54 Fed. Reg. 6900, Feb. 15, 1989, effective Apr. 17, 1989; 56 Fed. Reg. 55461, Oct. 28, 1991; 58 Fed. Reg. 54504, Oct. 22, 1993, effective Jan. 3, 1994; 58 Fed. Reg. 64155, Dec. 6, 1993, effective Jan. 3, 1994]

### Related Rules

- 35 U.S.C. 122. Confidential status of applications. (See *infra*, Patent Office Rules Book, U.S.C. section.)
- 18 U.S.C. 2071. Concealment, removal, or mutilation generally. (See *infra*, Patent Office Rules Book, U.S.C. section.)
- 42 U.S.C. 2181. Inventions Relating to Atomic Weapons, and Filing of Reports. (See *infra*, Patent Office Rules Book, U.S.C. section.)
- 42 U.S.C. 2182. Inventions conceived during Commission contracts; ownership; waiver hearings. (See *infra*, Patent Office Rules Book, U.S.C. section.)
- 35 U.S.C. 181. Secrecy of certain inventions and withholding of patent. (See *infra*, Patent Office Rules Book, U.S.C. section.)
- 35 U.S.C. 182. Abandonment of invention for unauthorized disclosure. (See *infra*, Patent Office Rules Book, U.S.C. section.)
- 35 U.S.C. 183. Right to compensation. (See *infra*, Patent Office Rules Book, U.S.C. section.)
- 35 U.S.C. 184. Filing of application in foreign country. (See *infra*, Patent Office Rules Book, U.S.C. section.)
- 35 U.S.C. 185. Patent barred for filing without license. (See *infra*, Patent Office Rules Book, U.S.C. section.)
- 35 U.S.C. 186. Penalty. (See *infra*, Patent Office Rules Book, U.S.C. section.)
- 35 U.S.C. 187. Nonapplicability to certain persons. (See *infra*, Patent Office Rules Book, U.S.C. section.)
- 35 U.S.C. 188. Rules and regulations, delegation of power. (See *infra*, Patent Office Rules Book, U.S.C. section.)
- 42 U.S.C. 2457. Property rights in inventions. (See *infra*, Patent Office Rules Book, U.S.C. section.)

[14.1]—Secrecy of certain inventions and licenses to file applications in foreign countries (Title 37 C.F.R., Part 5)n1

### [I.]—INTRODUCTION

Before a patent application can be sent for filing outside the United States, the provisions of 35 U.S.C. 184 must be met. Section 184 makes the disclosure of the U.S. application the sole device available to the PTO, absent a licensing petition, for determining what information an applicant might send abroad.n1.1 If not, the U.S. patent will be invalid

## Patent Office Rules and Practice Rule 14

under 35 U.S.C. 185, unless a retroactive license is obtained upon a showing of inadvertent filing. The penalties for willful disregard of these requirements are set out in 35 U.S.C. 186.n2

### (II.)—WHAT ARE THE REGULATED ACTS?

Merely sending out-of-the country *information* concerning an invention is not a violation of 35 U.S.C. 184, as the patent filing is the activity that is sought to be regulated. Whether disclosure of technical data to persons in the United States or abroad is an export of data is defined in the appropriate regulations of the export agencies having jurisdiction over the export of technical data related to the patent application. When an application is to be filed in an Iron Curtain country, the regulations of the Bureau of Foreign Commerce should be considered. A license may be required regardless of whether a U.S. Patent and Trademark Office license is mandated by 35 U.S.C. 184 (see 37 C.F.R. 5.19). Also, if a U.S. Patent and Trademark Office license is secured under 35 U.S.C. 184, and if the subject matter deals with a material set out on the Munitions List, a separate State Department license need not be secured (see 37 C.F.R. 5.18).

In the ordinary situations no license is required if the application being sent abroad for filing has been on file in the U.S. PTO for six months. If there is no U.S. patent application, however, or if the corresponding application has been on file in the U.S. PTO for less than six months, or if the application being sent abroad contains subject matter not found in the U.S. application, then a U.S. Patent and Trademark Office license is required (unless, possibly, a license under 37 C.F.R. 5.15(a) has issued, where modifications and supplements may be filed in certain circumstances). The statute states that, until there is a license, a person may not perform any one of the following three acts with respect to filing an application in a foreign country:

- (1) file;
- (2) cause to be filed; or
- (3) authorize to be filed.

What is the situation if an application is sent out for filing abroad but the license, that has been requested, is issued prior to the actual filing? Does this violate that portion of 35 U.S.C. 184 that states that "a person shall not file or cause or authorize to be filed ..." without the necessary license? In *Ex parte Glines*,<sup>n3</sup> the old Board of Appeals held that the *filing* was the intended act to be controlled. The Board, although holding the authorization of the filing before the license issued not to be a bar, warned:

"This is not intended to commend the order of events followed in this case or to indicate that the part of the law dealing with 'cause or authorize' would not be re-examined in a case where the exportation of material for filing compromised the opportunity of the defense agencies to accomplish the purposes of the law in question by refusing a license."

Note, that export regulations of agencies other than the PTO must be separately consulted for any possible violation.

35 U.S.C. 186 provides for criminal penalties upon conviction of one who "in violation of the provisions of section 184 of this title" files an application in a foreign country "in respect of any invention made in the United States." That one may, with impunity, disclose an invention in foreign countries by means other than an application is an irrelevant consideration where appellant's action does not fall within the apparent statutory void.n4

The C.C.P.A., in *In re Gaertner*, n5 stated:

"We do not hold that every domestic disclosure must under sections 184, 185 be limited to that which it recites in haec verbis. Certain technical information may be so commonly known that it can be said to be de facto expressly disclosed. Such instances would, however, fall within a narrow exception to the strict approach mandated by sections 184, 185."

Thus, the fact that the patent, read as whole, may be sufficient to teach a person of ordinary skill in the art to use nondisclosed subject matter, is irrelevant to Section 184; Members of the Security Group do not perform their Group function as persons of ordinary skill in the art. Therefore, it would be totally inappropriate to inject into determinations under Sections 184 and 185 full panoply of enablement considerations associated with determinations of compliance under Section 112.n6

## Patent Office Rules and Practice Rule 14

Not only is the application for a foreign patent (or for the registration of a utility, industrial design or model) regulated by 35 U.S.C. 184, but also modifications, amendments, supplements or divisions of such foreign patents. Thus, a supplemental disclosure filed in Canada is a patent application within the meaning of 35 U.S.C. 184.<sup>n7</sup>

Congress intended that strict compliance with 35 U.S.C. 184 and 185 be paramount to the interests of the individual inventors.<sup>n8</sup>

Sections 184 and 185 are not limited to inventions involving the national security.<sup>n9</sup> The decisions make it clear that even when the subject matter of the invention does not involve national security, a license is needed in all cases where a filing outside the U.S. is made within six months of the case being filed in the U.S. (or in any event where no U.S. application has been filed.)<sup>n10</sup> Noncompliance with 35 U.S.C. 184, 185 is not overcome by an argument that the claimed invention did not involve national security. The court, in *Minnesota Mining & Manufacturing Co. v. Norton*, Co.,<sup>n11</sup> stated:

"[I]t is not for the applicant to decide that Section 184 has no application to him. That is not his function. That is not his privilege. That is really not his business. It is the country's business."

The purpose of 35 U.S.C. 184 could be frustrated if the corresponding foreign application contained information not present in an examined-for-security-material U.S. application, or in a license for foreign filing. Congress clearly denied applicants the right to determine for themselves whether a particular disclosure was detrimental to national security, in providing that applications must be licensed for foreign filing, or must have been on file as a U.S. application for the requisite six-month period. The second paragraph of Section 184 extends those requirements to any modification, amendment, supplement or division of the foreign application that results in the disclosure of "new" information. Likewise, any modification, amendment, supplement, or division adding information to a previously filed U.S. application would reactivate the requirements of Sections 184 and 185 with respect to filing abroad an application disclosing the added information.<sup>n12</sup> Under the new foreign filing licensing rules, which came into effect June 4, 1984, such modifications, amendments etc., may be permitted if a 37 C.F.R. 5.15(a) license had issued.

Section 185 denies a patent on "an invention" to one who files nonlicensed foreign application for patent "in respect of the invention." Therefore, an applicant of a continuation-in-part application whose present foreign applications, containing "subject matter" of an example and claim added to parent application, are for patents "in respect of" invention described and claimed in his parent, is not entitled to a fall-back position in which he merely cancels or abandons all attempt to claim compound of that additional claim, and obtains a patent containing claims of his parent now copied in his present application. The deletion of the additional example and claim from his present continuation-in-part application cannot wash away his action of filing his foreign application without license. One may not file nonlicensed foreign applications, disclosing subject matter and invention in addition to, and in respect of, U.S. parent application, and thereafter escape the effect and intent of Sections 184 and 185 by merely declining to claim that additional subject matter. The fact that the applicant, because the parent had been on file for more than six months, could have obtained a patent for invention in his parent if foreign applications had not contained additional subject matter, is irrelevant.<sup>n13</sup>

35 U.S.C. 184 requires a license when the invention is "made in this country." *Selectro Corp. v. L.V.C. Industries Inc.*,<sup>n14</sup> discussed some of the questions involved in defining "made." As to the *conception* of the invention, the court held that this was not of significance in determining when an invention is made in the 35 U.S.C. 184 sense. Thus, the invention is made in the U.S. when the reduction to practice is made in the U.S. In this case, the question also arose as to whether the invention was made in the U.S. (and a license required), where part of the reduction to practice took place in the U.S. and part in Great Britain. A full determination of this issue was not necessary, however, to the specific ruling on a motion for summary judgment.

The regulations of the export agencies should be consulted even where the reexport of data originating from outside the U.S. takes place.

### **[III.]--WHAT IS AND WHAT IS NOT A MODIFICATION, ETC., OF A LICENSED INVENTION?**

When an application "in respect of an invention" is on file in the United States at least six months, then no license is needed to file abroad. But, the second paragraph of 35 U.S.C. 184 states that the term "application" includes "modifications, amendments, or supplements thereto or divisions thereof."

The question arises, with respect to continuation-in-part applications, as to whether these need a license, or whether the fact that the parent application has been on file in the U.S. Patent and Trademark Office for more than six months obviates the need for a license. In *Beckman Instruments, Inc. v. Coleman Instruments, Inc.*,<sup>n15</sup> the Seventh Circuit



characterized this question as whether the six months waiting period for the filing of the foreign applications commenced to run at the time of filing the first application, which is abandoned or commenced with the filing of the second application, upon which a patent issues. In this case, the patentee argued that both applications were for the same invention, and that the second, being a continuation-in-part, was entitled to the same filing date as the first. It was also argued that the foreign applications were for the same invention as described in the first application. The Court of Appeals demolished these contentions on the following grounds:

(a) The oath in support of the continuation-in-part application distinguished the second invention from the first with the statement that the continuation-in-part contained subject matter not disclosed in the parent application.

(b) The second paragraph of 35 U.S.C. 184 states that the term "application" as employed in the statute includes "any modification, amendment, or supplements thereto, or divisions thereof." Hence, the Court felt that "it is not open to doubt that the subject matter of the second application was a modification, amendment or supplement to the first."

The court stated:

"It follows that the foreign applications filed within six months after the filing of the second application, without obtaining a license, invalidated the patent.

"This construction is consistent with the purpose of the statute, which is to provide for the temporary withholding of all patent disclosures to ascertain if foreign filing might be detrimental to the national security. The specified six months' waiting period affords the Secretary of Commerce and other governmental departments an opportunity to examine the application for the presence of security material before the information is sent abroad. The statute would fail of its purpose if an applicant were permitted to file a first application disclosing some features of a secret invention; after a six-month period to file a continuation-in-part application disclosing additional essential features, and then without obtaining a license to disclose his invention abroad. It is logical to believe that the insertion of the second paragraph in Sec. 184 was intended to preclude such a result."

Note that a 37 C.F.R. 5.15(a) license under the regulations in effect on June 4, 1984 would have overcome the above problem.

While the patentee obtained a retroactive license, the Illinois District Court, in *Blake v. Bassick Co.*,<sup>n16</sup> passed on the following situation:

"Blake's earlier patent application dated October 24, 1946 stated inter alia that:

" 'This invention relates to a supporting attachment and it is primarily an object of the invention to provide a device of this kind adapted for use with furniture or the like to afford means for compensating for any unevenness in the surface upon which the article may be placed, or with respect to the length of supporting legs so that the article of furniture is prevented from rocking.

" 'Another object of the invention is to provide a device of this kind including the use of both a fluid and a compression element to obtain the result desired.'

"The later application, filed July 24, 1948, stated in part:

" 'This invention relates to leveling devices for furniture and the like, and its chief object is to provide simple automatic devices for preventing tables, cabinets, refrigerators and other articles and machines from rocking when they are resting on an uneven floor.'

"The British patent specification states:

" 'This invention relates to furniture, and it consists of devices to be put on the bottoms of the legs of tables, ... and the like to prevent them from rocking when they are on a floor that is not perfectly flat. These devices are short extensions of the legs and they automatically adjust themselves to the floor, ... ' "

In passing on the above facts, the Illinois District Court stated:

"It seems probable that Blake's earlier U.S. patent application covered an invention bearing evident similarity to his later U.S. application, so as to justify his belief that no further appraisal of the Patent Office was necessary to prevent statutory invalidation of any patent he might procure despite the lack of a license to apply abroad."

After the *Beckmann*<sup>n17</sup> decision, the Court that passed on *Blake* was asked to review its decision, and it stated:<sup>n18</sup>

## Patent Office Rules and Practice Rule 14

"In the instant case, both applications, which were copending, were allegedly for the same invention, and also for the same invention as covered by the British application ...

"The court therefore feels that this is a vital distinguishing feature between the Beckman case and the instant one; here both applications allegedly covered the same invention, and the patentee is therefore entitled to date the six months' period from the filing of the first rather than the second application."

In *Blake*, the patent issued on the later application. The British application was filed on April 26, 1948. The first application of October 24, 1946, was abandoned. Apparently no continuation-in-part oath was involved.

Where a claim is first found in a foreign case that for the first time omits the requirement that a catalyst is needed, whereas the U.S. patent, on which a license was secured, made the catalyst a required component, then the U.S. patent will be held invalid under 35 U.S.C. Sections 184 and 185.

In *Control Systems Research, Inc. v. Aerotech, Inc.*,<sup>n19</sup> the issue was whether the fact that Figures 9 through 16 found in the foreign application, and not found in the draft application submitted with the petition for license (but which figures 9 through 16 were referred to repeatedly in the draft application) invalidated the patent under 35 U.S.C. 184 and 35 U.S.C. 185. The court held "that to be fatal to patentability under 38 U.S.C. 185 the discrepancy must contain something essential to the identity of the invention such that the new formulation amounts to disclosure in the foreign application of a different invention 'not disclosed' in the original material accompanying the petition for the license to file abroad."

The C.C.P.A., in *In re Gaertner*,<sup>n20</sup> did not hold to the statements that had been made in *Control Systems Research, Inc. v. Aerotech Inc.*,<sup>n21</sup> and *Beckman Instruments, Inc. v. Coleman Instruments, Inc.*,<sup>n22</sup> suggesting that discrepancies in the U.S. and foreign disclosures must be "essential to the identity of the invention" or related to "essential features" of the invention to be fatal under 35 U.S.C. 184, 185. *Gaertner* held that, for purposes of Section 184 the question of whether "modifications, amendments or supplements" of applications constitute "modifications, amendments or supplements" of applicant's "invention" is irrelevant.<sup>n23</sup>

In *Transitron Electronic Corp. v. Hughes Aircraft Corp.*, the District Court of Massachusetts held that claims on file as an *amendment* in the U.S. case for more than six months clearly constituted "an application" in the United States that would authorize a filing outside the United States under 35 U.S.C. 184.<sup>n24</sup>

#### [IV.]—RETROACTIVE LICENSE

Where there has been inadvertent filing abroad without the necessary license, it is possible to cure the defect by securing a retroactive license. In view of the final sentence of 35 U.S.C. 185, it has been contended (by defendants in infringement suits) that the retroactive license has no effect once the U.S. patent has issued.

The question has been considered as to whether the Commissioner has the power to grant a retroactive license to file applications abroad when based on inadvertence and sought with diligence under 35 U.S.C. 184. The weight of authority is that he does.<sup>n25</sup>

Set out below are the arguments for the proposition that the Commissioner's retroactive license applies only when the U.S. application is pending and has no effect on a patent. It should be noted, however, that only one District Court has so held,<sup>n26</sup> and this holding has been reversed.<sup>n27</sup>

The arguments are:

(1) Congress has accorded the Patent and Trademark Office some limited areas of jurisdiction where it can control or affect patents after their issuance. Except for these specifically defined instances, he may not assert his authority over an already-issued patent.<sup>n28</sup>

(2) The Boykin Act (Act of August 8, 1946, Pub. L. 690, 79th Cong. 2d Sess. Ch. 910, 60 Stat. 940) also had restrictions on filing outside of the U.S. without proper authorization, but it specifically had provision for the Commissioner of Patents to authorize the filing of application in such foreign country so as to save the *patent* that issued from invalidity. The words in 35 U.S.C. 184, it is argued, omit this specific authority to the Commissioner, and the retroactive license is believed to apply only to the "application." This interpretation, it is further argued, is supported by the final sentence of 35 U.S.C. 185.<sup>n29</sup>

## Patent Office Rules and Practice Rule 14

(3) The granting of retroactive license in 35 U.S.C. 184 was provided merely to relieve the violator from the penalties set out in 35 U.S.C. 186.n30

The Court in *Pillsbury Co. v. General Mills Inc.*,n31 rejected the above arguments as follows:

"[T]he clear weight of authority is to the effect that the Commissioner of Patents has the authority under Section 184 to grant a license retroactively to a patentee where a United States patent has been issued and application has been inadvertently filed abroad within the six months' period without the approval of the Commissioner and where the application does not disclose an invention within the scope of Section 181 of Title 35, United States Code (citations omitted). "The legislative history of Sections 184 and 185 does not suggest an interpretation of these statutes contrary to the majority holding as above stated. Moreover, it may be noted that in the *Minnesota Mining and Manufacturing Co.* case, the court, in part, at least, rested its decision and was led astray by its conclusion and that the word 'application' in Section 184 referred to the domestic application for the patent rather than the foreign application for which the license is to be granted. However, defendant urges with great assurance that a United States patent issued without procuring the license prescribed in Section 184 when a foreign patent is applied for within the six months' period after the United States filing, becomes invalid and the Commissioner is without authority to breathe life into an invalid patent. It urges that such a patent having entered the public domain cannot again become a patent monopoly by a fiat of the Commissioner of Patents. Defendant poses the question as to the length of time a patentee could procrastinate before he reclaims his patent from the public domain by obtaining a so-called retroactive license from the Patent Commissioner. There has been no showing here of procrastination...

"The argument that the granting of a retroactive license provided for in Section 184 was enacted for the purpose of relieving a violator of Section 185 from the penalties provided in Section 186 would seem to be without any substance. It is surely less than convincing to urge, as defendant does, that Congress solely intended that the Patent Commissioner, by the issuance of a retroactive license, should render one immune from the penalty provided in Section 186. In any event, if that was one of the purposes of the statute, it does not negative the intention of Congress to relieve one of an innocent mistake in failing to comply with Section 184 where it is apparent that the national security of the United States was not involved...

"The broad language as to the right of the Commissioner to grant a retroactive license under Section 184 does not disclose any intention of Congress to limit the Commissioner's authority in this regard to unissued patents. It is not made to appear that the defendant or any member of the public will be, or has been, prejudiced by the interpretation of Section 184 which this Court now adopts, or that the safety of this country has been endangered in any way by the inadvertence of the plaintiff in failing to obtain a license within the six months' period. An interpretation of the law which is needlessly harsh is not justified under the admitted circumstances."

The weight of authority mentioned by the Court in *Pillsbury* include certain cases already discussed.n32 The cases referred to in the Court of Appeals decision reversing the District Court should also be consulted.n33 Further cases holding that a retroactive license issued by the Commissioner of Patents cures the invalid patent are set out elsewhere.n34

The above cases holding that the retroactive license cures the invalid patent, however, relate to situations where the retroactive license was granted before any judicial declaration of invalidity had been made. The Southern District of New Yorkn35 held that the issuance of a retroactive license was insufficient under *Rule 60(b) of the Federal Rules of Civil Procedure* to withdraw a previous order of patent invalidity and dismissal of suit on the grounds of failure to comply with 35 U.S.C. 184 and 185. Such a retroactive license was held not to constitute the "mistake, inadvertence, surprise, or inexcusable neglect" or "newly discovered evidence" contemplated by Rule 60(b) on the grounds for which an original action would be revived. The question whether a new action could be started was not determined.

It is open to any interested party to seek judicial review of the reliability of the evidence upon which the Commissioner acted in granting a retroactive license.n36

Where an invention was within the scope of 35 U.S.C. 181, the Commissioner of Patents was without authority, in view of limitations specified in Section 184, to grant a valid retroactive license even though a secrecy order never issued with respect to it.n37 However, the District Court of the District of Columbia disagreed with this decision of the District Court of Utah, and instead heldn38 that a retroactive license may issue under 35 U.S.C. 184 where the inventor inadvertently filed abroad and the United States application had not been the subject of a secrecy order under section 181. The Court so held even though the Commissioner, believing that disclosure of the invention might be detrimental

to national security, had made the application available for inspection to the Atomic Energy Commission and other government agencies, which agencies had recommended against issuance of a secrecy order.

The decision by the PTO that a retroactive license is not necessary appears to have the same binding effect upon a federal court as the granting of a retroactive license.<sup>n39</sup>

#### **[A.]—Review of Commissioner's decision regarding retroactive license.**

If a challenge is made as to the validity of a retroactive license issued by the Commissioner, or the grounds upon which it was granted, then it appears that same might most appropriately be done by an independent action *against the Commissioner*, either in *mandamus* (28 U.S.C. § 1361) or by review under the Administrative Procedure Act (5 U.S.C. § 701, *et seq.*).<sup>n40</sup> Of course, the scope of the Commissioner's discretion in granting a retroactive license may impair a defendant's pursuit of either course of action.<sup>n41</sup>

#### **[V.]—TIME FOR FILING PETITION FOR RETROACTIVE LICENSE**

In *Blake v. Bassick Co.*,<sup>n42</sup> the Court dealt with the question of whether a delay of eight years after the patent grant vitiated the retroactive license and held the license effective. This case involved the situation where the retroactive license was requested promptly after discovery of the improper foreign filing.

After the Seventh Circuit, in *Beckman Instruments Co. v. Coleman Instruments, Inc.*,<sup>n43</sup> held that the disclosure of the later application differed materially from that of the earlier one and that, accordingly, the fact that the earlier case had been pending for more than six months when the foreign applications were filed did not obviate the requirement for a license, and a petition was filed for a retroactive license.<sup>n44</sup> The petitioner delayed the request for a retroactive license for over a year and asserted, in justification of these delays, that the petitioner:

"was entitled to await the final court decision and that thereafter it was necessary to collect records and consider various court decisions."

The Commissioner ruled against granting the license, saying:

"It is not thought that this course of conduct can properly be considered as constituting the requisite diligence under the circumstances of this case. Clearly the question as to whether a retroactive license would be granted should have been raised and determined at least no later than the time when the validity of the patent was first challenged, since the granting of such a license might have had a very material effect on the court proceedings. Moreover, it is definitely in the public interest that such a question be promptly settled in order that the status of the patent may be known with certainty."

#### **[VI.]—ARE THERE INTERVENING RIGHTS BEFORE RETROACTIVE LICENSE IS GRANTED?**

The question of intervening rights was raised in *Blake v. Bassick Co.*,<sup>n45</sup> when the retroactive license was granted some eight years after the patent grant. The defendants maintained that the doctrine of equitable estoppel was assertable to support their "intervening rights," and contended that a license may not make a long-issued patent retroactively valid as otherwise the public would have no way of knowing whether a patent was valid or invalid, if it were possible to grant a license after the issuance of a patent.

The Court denied this argument stating:

"The Court does not at this time deem comparable the doctrine of intervening rights, obtainable where there is a reissue of a patent because of inadvertent failure to make a justifiable disclosure and claim for patent protection, which earlier failure to disclose, an infringer may use as a defense. There the alleged infringer is justifiably relying on the disclosure actually made by a patent which disclosure is later changed to his detriment.

"In the instant case there is no change in the scope of the disclosure; there is what might be deemed a 'condition precedent' to the validity of a patent in toto, which invalidity could be compared to invalidation of issued patent for failure to disclose pertinent prior art."

Where a retroactive license is granted, it has been held that the policy of 35 U.S.C. 181-185 is not best served by limiting damages to the period after the date of the retroactive license.<sup>n46</sup>

#### **[VII.]—WHAT IS INADVERTENCE?**

## Patent Office Rules and Practice Rule 14

A retroactive license can be granted under the provision of 35 U.S.C. 184 only when the foreign filing is inadvertent. Inadvertence signifies want of attention. If the foreign filings are deliberately effected, with full knowledge of the pertinent law and facts, such filings are not inadvertent.<sup>n47</sup>

There is no showing of inadvertence when the applicant's position has always been that no license was or is necessary to support the foreign filing.<sup>n48</sup>

The determination of whether there has been inadvertence is based on a submission of all the facts to the PTO. A mere allegation that there has been inadvertence does not provide sufficient information to properly evaluate a license request.<sup>n49</sup>

Inadvertence was discussed in a Commissioner's decision<sup>n50</sup> as follows:

"In support of the petition it is asserted that the petitioner was aware of the statutory provisions here involved at the time when the foreign applications were filed but was of the opinion that the disclosure in his first United States application was the same in all material respects as that of the second and that since the first had been filed more than six months prior to the foreign filings, no license was necessary. The petitioner still contends that there is no material difference between the disclosures of the two United States applications but, in view of the decision in the Beckman case above cited,<sup>n51</sup> that question is not thought to be open for consideration here. Moreover, assuming the petitioner's contention to be correct, there would have been no inadvertent foreign filing and no retroactive license would be needed or proper.

"Under the provisions of 35 U.S.C. 184 a retroactive license can be granted only when the foreign filing was inadvertent. Inadvertence signifies want of attention and an action which is deliberately taken with full knowledge of the pertinent law and facts, is not inadvertent *In re French*, 24 CCPA 1218, 33 USPQ 537. *In re Cornell et al.*, 32 CCPA 1251, 66 USPQ 320; *In re Smyser*, 30 CCPA 1093, 57 USPQ 402. The foreign filings here involved were deliberate and the petitioner does not, even now, assert that the law required them to be supported by a license. It must therefore be held that they were not inadvertent within the meaning of the applicable statute, and that a retroactive license cannot properly be granted."

The Notice of February 24, 1984,<sup>n52</sup> promulgating the changes in PTO licenses for foreign filing that came into effect June 4, 1984, discusses the meaning of inadvertence as follows:

"Inadvertence is a statutory standard which cannot be altered by rulemaking. Further, judge-made law has determined the metes and bounds of this term which further proscribes the rulemaking authority of the Commissioner. In *Barr Rubber Products Co. v. Sun Rubber Co.*, 149 USPQ 204, 209 (S.D.N.Y., 1966) inadvertence was defined as 'lack of care or attentiveness: inattention' or 'an effect of inattention: a result of carelessness; an oversight, mistake, or fault from negligence.'

"Inadvertence signifies want of attention, and an action which is deliberately taken with full knowledge of the law and facts is not inadvertent. *In re Application of November 22, 1952*, 153 USPQ 410, 411 (*Asst. Commr. 1967*)."

#### [VIII.]—DILIGENCE IN SECURING RETROACTIVE LICENSE

The requirements for the petition for a retroactive license (in 37 C.F.R. 5.25 which came into effect June 4, 1984) indicate that the petition shall include: "A showing that the license has been diligently sought after discovery of the proscribed foreign filing."

The question of diligence was discussed in a Commissioner's decision<sup>n53</sup> as follows:

"Moreover, even assuming inadvertence to have been present, it was clearly incumbent on the petitioner to apply for a retroactive license with diligence as soon as the need for it became apparent. It appears from the petition that the petitioner was aware, in March 1963, that the validity of his patent might be questioned on the ground of unlicensed foreign filing and that a decision was made to stand on the position that no license was necessary. Even after the Court of Appeals of the Seventh Circuit had held, on November 9, 1964, that a license was necessary, the filing of a petition for a retroactive license was delayed by more than a year. In justification of these delays it is asserted that the petitioner was entitled to await the final court decision and that thereafter it was necessary to collect records and consider various court decisions.

"It is not thought that this course of conduct can properly be considered as constituting the requisite diligence under the circumstances of this case. Clearly, the question as to whether a retroactive license would be granted should have

been raised and determined at least no later than the time when the validity of the patent was first challenged, since the granting of such a license might have had a very material effect on the court proceedings. Moreover, it is definitely in the public interest that such a question be promptly settled in order that the status of the patent may be known with certainty.

"For the foregoing reasons it must be held that the requested retroactive license cannot properly be granted and the petition is accordingly denied."

#### **[IX.]—LICENSE REQUEST FOR FOREIGN FILING UNDER THE PCT**

Section 1832 of the M.P.E.P. (5th Ed., 13th Rev.) discusses this situation as follows:

"A license for foreign filing is not required to file an international application in the United States Receiving Office but may be required before the applicant or the U.S. Receiving Office can forward a copy of the international application to a foreign patent office, the International Bureau or other foreign authority (*35 U.S.C. 368, 37 CFR 5.1 and 5.11*). A foreign filing license to permit transmittal to a foreign office or international authority is not required if the international application does not disclose subject matter in addition to that disclosed in a prior U.S. national application filed more than six months prior to the filing of the international application (*37 CFR 5.11(a)(2)*). In all other instances, the applicant should petition for a license for foreign filing (transmittal) (*37 CFR 5.12*) and if appropriate, identify any additional subject matter in the international application which was not in the earlier U.S. national application (*37 CFR 5.14 (c)*). This request and disclosure information may be supplied on the PCT international application transmittal letter, form PTO-1382.

"If no petition or request for a foreign filing license is included in the international application, and it is clear that a license is required because of the designation of foreign countries and the time at which the Record Copy must be transmitted, it is current Office practice to construe the filing of such an international application to include a request for a foreign filing license. If the license can be granted it will be issued without further correspondence. If no license can be issued, or further information is required, applicant will be contacted. The automatic request for a foreign filing license does not apply to the filing of a foreign application outside the PCT.

#### **"Effect of Secrecy Order**

"If a secrecy order is applied to an international application, the application will not be forwarded to the International Bureau as long as the secrecy order remains in effect (PCT Article 27(8) and *35 U.S.C. 368*). If the secrecy order remains in effect, the international application will be declared withdrawn (abandoned) because the Record Copy of the international application was not received in time by the International Bureau (*37 CFR 5.3(d)*, PCT Article 12(3), and PCT Rule 22.3). It is, however, possible to save the U.S. filing date, if the United States of America has been designated, by fulfilling the requirements of *35 U.S.C. 371(c)*."

**FORMS:** For related forms see Chapter 13 of the **\*\* Volume to this Treatise.**

#### **[X.]—PTO PROCEDURE WITH GRANTED LICENSE**

The fact that a license has been granted is noted in the appropriate file. The procedure was set out in former Section 107 of the M.P.E.P. (5th Ed., 13th Rev.) as follows:

"All licenses granted by the Commissioner of Patents and Trademarks to file patent applications in foreign countries are made of record in the application to which they correspond. A petition for a license and the license resulting therefrom are given paper numbers and endorsed on the file wrapper. Petitions for licenses which are not approved are recorded and placed in the application file wrapper."n54

#### **[14.2]—Pending applications secret; other records open to public.**

Pending applications are preserved in secret, as per Rule 14 *supra*. Other records may be open to the public, including assignment records, as per Rule 12 *supra*. But after a patent issues, the application and all other papers pertaining to it are open to the public, as per Rule 11. This is also true of interferences after the applications involved have matured into patents, Rule 11.

*35 U.S.C. 122* provides that one may not learn an inventor's ideas simply by requesting information from Patent and Trademark Office. Section 122 and PTO Rule 14(a) protect not only the application itself but also all pertinent

## Patent Office Rules and Practice Rule 14

information given to examiners by inventors or attorneys pending the grant, denial, or abandonment of an application. Thus, a third party was not entitled to inspect Form PO 892 used in a pending application.<sup>n1</sup>

The **Notice of June 12, 1918, Revised**, states that: "Examiners, while holding interviews with attorneys and applicants, should be careful to prevent exposures of files and drawings of other applicants."<sup>n2</sup>

**[14.3]—Power to inspect pending applications.<sup>n1</sup>**

It is to be noted that a "power to inspect" is, in effect, the same as a "power to inspect and make copies." The applicant, the assignee of record, and the attorney of record have access to the file of their pending application. No other person can have access thereto unless:

- (a) he has written authorization or power to inspect<sup>n2</sup> from any one of the three enumerated above; or
- (b) on written order from the Commissioner.

The power to inspect (a) or the order from the Commissioner (b) must be filed and becomes part of the record of the case. *Commissioner's Order No. 1271*.<sup>n3</sup> The power to inspect must be approved in writing by the Examiner or by the head of specified departments. Commissioner's Administrative Order No. 10<sup>n4</sup> states:

"Every power to inspect must be approved in writing by the Examiner in charge of the Division to which the application is assigned before permission to inspect is granted. Permission to inspect may also be granted by the Patent Reference Branch, the Manuscript and Lithographic Branch, and the Issue and Gazette Branch.

"Power to inspect or make copies presented at the Patent Reference Branch, the Manuscript and Lithographic Branch, and the Issue and Gazette Branch must be approved in writing by the head of the respective organizational unit. The assistant head of the Issue and Gazette Branch is authorized to act for the head of that Branch in his absence in approving powers to inspect."

The current practice is set forth in Section 104 of the Manual of Patent Examining Procedure the basis of which is **Notice of November 24, 1971**:<sup>n5</sup>

"No person but the applicant (any one of joint applicants), applicant's legal representative, the assignee whose assignment is of record, or the attorney, agent or associate attorney of record will be permitted to have access to the file of any pending application, except as provided for under *37 CFR 1.11(b)* or under the interference rules, unless written authority from one of the above indicated parties, identifying the application to be inspected and the name of the person authorized to have access, is made of record, or upon the written order of the Commissioner, which will also become a part of the record of the case.

"Approval by the primary examiner of a power to inspect is *not* required. The clerk of the group to which the application is assigned ascertains that the power is properly signed by one of the above indicated parties, and if acceptable, enters it into the file. If the power to inspect is unacceptable, notification of non-entry is written by the clerk to the person who signed the power.

"When a power to inspect is received while a file is under the jurisdiction of a service branch, such as the Customer Services Division, the Service Branch of the Board of Appeals, and the Patent Issue Division, the question of permission to inspect is decided by the head of the branch who, if he or she approves, indicates the approval directly on the power.

"A 'power to inspect' is, in effect, the same as a 'power to inspect and make copies.'

"Where an applicant relied upon his application as a means to interfere with a competitor's business or customers, permission to inspect the application may be given the competitor by the Commissioner. (*Ex Parte Bonnie-B Co. Inc.*, 1923 C.D. 42; 313 O.G. 453). Such permission is via petition for access under *37 CFR 1.14(c)*.<sup>n6</sup>

"An unrestricted power to inspect given by an applicant is, under existing practice, recognized as good until and unless rescinded. The same is true in the case of one given by the attorney or assignee so long as such attorney or assignee retains his or her connection with the application.

"Permission to inspect given by the Commissioner, however, is not of a continuing nature, since the conditions that justified the permit to inspect when given may not obtain at a later date.

**"ACCESS TO PATENT APPLICATION AND INTERFERENCE FILES**

## Patent Office Rules and Practice Rule 14

"In order to insure that access to patent application other than reissue applications filed after March 1, 1977, and interference files is given only to persons who are entitled thereto or who are specially authorized to have access under 37 CFR 1.14 and to insure also that the file record identifies any such specially authorized person who has been given access to a file, the following practice will be observed by all personnel of the Patent and Trademark Office:

"1 Access, as provided for in the Rules of Practice, will be given on *oral request* to any applicant, patentee, assignee, or attorney or agent of record in an application or patent only upon *proof of identity* or upon recognition based on personal acquaintance.

"2 Where a power of attorney or authorization of agent was given to a registered firm prior to July 2, 1971, access will be given upon oral request as in paragraph 1 above to any registered member or employee of the firm who has signatory power for the firm.

"3 Unregistered employees of attorneys or agents, public stenographers, and all other persons not within the provisions of paragraphs 1 and 2 above will be given access only upon presentation of a *written authorization for access* signed by a person specified in paragraph 1 above, which authorization will be entered as a part of the official file."

"*Disbarred attorney cannot inspect.*" Section 105 of the M.P.E.P. (5th Ed., 13th Rev.) states: "Patent and Trademark Office employees are forbidden to hold either oral or written communication with an attorney who has been suspended or excluded from practice regarding an application unless it be one in which said attorney is the applicant. Power to inspect given to such an attorney will not be accepted."

**FORMS:** See the \*\* Volume to this Treatise, Chapter 12, for related forms.

**[14.4]—Inventor vs. assignee of entire interest.**

The assignee of record of the entire interest of an invention is entitled to control the prosecution of the application, Rule 32 (37 C.F.R. 1.32). This is customarily done by revoking the power of attorney given by the inventor and appointing a new attorney. But if the assignee does not assert this right, the office will continue to recognize the attorney of the assignor inventor.<sup>n1</sup> The latter, however, may still inspect the file unless the assignee of the entire interest requests (by petition) that the file be barred to the inventor.<sup>n2</sup> The assignee may do this *without the necessity of a showing* of reasons why the inventor should be excluded. The excluded inventor may then petition for permission to inspect *upon a showing* why it is necessary for him to inspect the file,<sup>n3</sup> as, for example, to prepare foreign applications or to maintain proper lines of division between it and other applications.<sup>n4</sup>

**[14.5]—Assignee of partial interest.**

While it is only the assignee of the entire interest who can intervene in the prosecution of an application or interference to the exclusion of the applicant, the assignee of less than the whole interest in an invention, whose assignment is recorded, has a right either himself or by his attorney to inspect the file application.<sup>n1</sup>

This is also true of a grantee,<sup>n2</sup> i.e., one whose rights are limited territorially (but who has no control in the prosecution).

**[14.6]—Licensee.**

A mere licensee is not given access by the Patent and Trademark Office to pending applications, for a licensee owns no interest in the patent.<sup>n1</sup> A transfer of the exclusive right to make, use and sell, although worded as a license, is however a full assignment.<sup>n2</sup> Such an exclusive licensee has the full rights of an assignee of the entire interest. A mere licensee, however, will be given access to the files upon a showing of good and sufficient reasons for the request.<sup>n3</sup> A licensee's wish to determine whether an application has been properly prosecuted is not a sufficient reason.<sup>n4</sup> This right should have been provided for in the contract of license.<sup>n5</sup> A licensee may inspect the file upon court order, by filing a certificate to that effect.<sup>n6</sup> A licensee of an exclusive right is entitled to inspect the application.<sup>n7</sup>

**[14.7]—Power to inspect: Litigants.**

The Patent and Trademark Office will deny<sup>n1</sup> a petition for access where the only grounds for the request is that the litigant believes that knowledge of the contents of the application might be of assistance to him in conducting his case.<sup>n2</sup> The proper procedure is to file a certificate from the court before whom the suit is pending stating that the application would be relevant and material.<sup>n3</sup> However, a certificate or order of the court is not essential, as it is



sufficient if the petition for access shows the relevancy and materiality of the application.<sup>n4</sup> Even where a court order is filed, the Commissioner will nevertheless independently ascertain whether the application relates to inventions that bear upon the questions at issue in the suit.<sup>n5</sup> A petition for access to an abandoned application that was involved in an interference with an application that matured into a patent for purpose of litigation involving the patent will be denied.<sup>n6</sup>

A sufficient showing is that the defendant desires to determine whether or not the application upon which the patent in suit issued was a proper division of the pending application.<sup>n7</sup> Another sufficient showing would be a defendant's desire to determine the earliest effective filing date of the patent in suit as grounded on the pending application.<sup>n8</sup> It is the settled practice<sup>n9</sup> of the PTO to permit access to applications where it appears that the pending application had some bearing upon the granting of claims in the patent in suit.<sup>n10</sup> Where the whole prosecution of the patentability of a specific species covered by a patent claim appears on patentee's abandoned application, the paramount interest of the public to see what prosecution occurred in the abandoned application of the subject matter claimed in the patent is held by the Commissioner to be a special circumstance justifying access under 35 U.S.C. 122.<sup>n11</sup> Also, a defendant, by his pleadings, may waive the right to secrecy of his application under 35 U.S.C. 122.<sup>n12</sup>

Particularly in view of the deposition and discovery rule of the Federal Rules of Civil Procedure, a petitioner must make a showing of special circumstances as to why he is entitled to access to pending or abandoned applications.<sup>n13</sup>

As pointed out in the case of *Great Lakes Carbon Corp. v. Continental Oil Co.*, applications for patents are secret documents and not available to the public generally. While in some rare instances it is necessary to require the disclosure of a pending application, the practice should be confined to instances where the information is absolutely essential for a party to a lawsuit to properly prepare for trial. This is especially true where the litigants are competitors. This does not mean that the interest of a patent applicant is to prevail over the right of a party to litigation to discovery in full truth.<sup>n14</sup>

Although 35 U.S.C. § 122 provides that the Patent and Trademark Office shall maintain the confidentiality of a patent application, that prohibition is not binding on a United States District Court.<sup>n15</sup> which court may order the release of the material where the movant's need for the material outweighs the applicant's interest in the confidentiality of its application.<sup>n16</sup>

The absence of a statutory prohibition on the district court does not mean that there is an automatic entitlement to abandoned and pending file wrappers. Rather, the question of whether disclosure should be ordered requires a balancing of competing policy and litigation interests. Disclosure of file wrappers of pending and abandoned applications should be ordered when the necessity for disclosure outweighs the desirability of maintaining the secrecy of data in the file wrapper, especially if protective measures can be fashioned to minimize the intrusion or to prevent excessive dissemination of the revealed material. Conversely, if the need to examine the file wrapper is less than the interest served in protecting secrecy, or if confidentiality could not be effectively protected by other means, disclosure should not be ordered.<sup>n17</sup>

#### **[14.8]--Reissue application.**

Rule 179 (37 C.F.R. 1.179) provides that when an application for a reissue is filed, there will be placed in the file of the original patent a notice stating that an application for reissue has been filed, giving its serial number and filing date. When the reissue is granted, or the reissue application is otherwise terminated, that fact will be added to the notice in the file of the original patent. The defendant in a suit upon a patent for which reissue application has been filed may obtain access thereto by petition.<sup>n1</sup> In one case, the alleged infringer in an infringement litigation was allowed to submit prior art to the examiner in the course of the reissue prosecution. However, the Court upheld the holding of the PTO that refused participation by the alleged infringer in the consideration of the patent application.<sup>n2</sup> Also, the opponent in an interference with the reissue application will have access to the file of the original application.<sup>n3</sup>

#### **[14.9]--Threatening letters of applicant.**

An applicant may inform a competitor who is marketing a device covered by the application, of his pending application without waiving right of secrecy.<sup>n1</sup> But if the applicant should interfere with the business of the competitor in this matter, the Patent and Trademark Office will permit the competitor, on petition, to inspect the application.<sup>n2</sup>

The fact that one notifies specific individuals (who are petitioning for access) that there is a pending application that may cover the product that the individuals make, use or sell is not such an interference as to warrant a waiver of the

## Patent Office Rules and Practice Rule 14

secrecy guaranteed by 35 U.S.C. 122 and Rule 14 (37 C.F.R. 1.14). Such a notification is no more than a notice as to an application and the owner's intent to enforce his rights, when and if the patent is granted. When the customers of the petitioner have not been threatened and the petitioner's business has not suffered, the petition for access will be denied.<sup>n3</sup>

**[14.10]--Waiver by reference.**

A reference to a pending application may constitute a waiver of secrecy and permit any interested party to inspect the application upon petition, if the nature of the reference to the pending application indicates that it was relied upon for any purpose in the proceeding eventuating in the patent granted.<sup>n1</sup> The customary legend that "this invention is an improvement of pending application" so-and-so, is itself insufficient to establish such reliance.<sup>n2</sup> (In this case, the petitioner was involved in interference with the application that made the reference.)

When the reference in the issued patent states that it is a *continuation* or *substitute* for another application, access to the application referred to may be had upon request and without a showing of interest.<sup>n3</sup> But where the application upon which the patent was granted was a *division* of an earlier application, then access to the earlier application will be permitted only upon a showing of interest.<sup>n4</sup> This is because the earlier application discloses other inventions besides those included in the patent, and which inventions should not be made public property or be disclosed to a stranger to the record.<sup>n5</sup> The defendant in an infringement suit upon a patent wherein it is stated that it is a division of another application does make a sufficient showing of interest, as he has a right to ascertain whether the patentee can rightfully rely on the earlier filing date.<sup>n6</sup>

The reference may appear in the patent<sup>n7</sup> itself; in the file wrapper<sup>n8</sup> of a patent; in a pending application that is revealed to an interferant;<sup>n9</sup> and, in one early case,<sup>n10</sup> the reference to the earlier case had been cancelled by amendment.

**[14.11]--Power to Inspect: Abandoned Applications, Referred to in Issued Patent.**

If the abandoned application is referred to in an issued patent, inspection and copies may be obtained by mere request (in writing), as per Rule 14. It is thus seen that Rule 14 overrides the requirement that it must first appear that the earlier (abandoned) application was relied upon in the proceeding eventuating in the patent granted.<sup>n1</sup> cited. Rule 14 has been clarified on this matter by the PTO Solicitor,<sup>n2</sup> who stated:

"Ordinarily, a mere gratuitous reference in a patent to a pending application, e.g., one not claiming the benefit of the application's filing date, does not give rise to a right of access by the public to that application. The situation is quite different where, as here, the application is formally and positively incorporated by reference into the patent."

The specific legal incorporation by reference was held to be a waiver of the confidentiality requirement of 35 U.S.C. 122.<sup>n3</sup>

Access to the abandoned application will be permitted upon request under Rule 14, whether the issued patent is stated to be a substitute or continuation of the abandoned application--which access was possible even before Rule 14<sup>n4</sup> --or whether the issued patent was stated to be a division of the abandoned application.

**[14.12]--Abandoned Applications: "Clear Record."**

It had been attempted at one time to prosecute an application to allowance, then abandon it and subsequently file a substitute case identical with the one allowed that would then be issued as a patent without reference to the abandoned application. In this way, the patent will appear to have been "allowed on the first action," and its file wrapper would afford no aid to a defendant or others in seeking to limit the coverage of the patent.

Under such circumstances, Rule 14 would not be of much value because the issued patent would bear no reference to the abandoned application. However, the courts have held that the abandoned application should be accessible merely upon request.<sup>n1</sup> The Commissioner stated that the proceedings in the abandoned application are, in fact, a part of the proceedings that led to the grant of the patent, and should be as much open to the inspection by the public as the record in the patented file.

To combat this practice, the PTO<sup>n2</sup> required that the Examiner indorse upon the file-wrapper a statement that the issued application is a substitute or continuation of the abandoned one.

Old Rule 78 then required cross-references in applications claiming an invention disclosed in a *prior filed application*. This requirement for cross-reference to the earlier application is thus effective to forestall any attempt to secure a "clean" file wrapper record.

However, this provision under old Rule 78 only held true where the benefit of the filing date of the parent application is claimed, or can be claimed, *e.g.*, a division, continuation or substitute application. But in those cases where the benefit of the filing date of the parent application is not claimed, no notation as to the parent case is made on the face of the file wrapper.<sup>n3</sup>

**[14.13]--Power to Inspect: Interferants.**

Parties in interference have the right to access to pending applications involved in the contest and, under the proper circumstances, to other pending or abandoned applications of the parties. This aspect of the rule of secrecy is discussed in connection with interferences, at old Rule 226. But it should be noted here that superseded Rule 15 had pointed out this exception by naming old Rules 97, 103 and 108, all relating to interferences. This reference is omitted in new Rule 14.

**[14.14]--Petition for Access: Procedure.**

**[I.]--ABANDONED APPLICATIONS REFERRED TO IN ISSUED PATENT**

Rule 14, *supra*, provides that access may be had in such cases on request in writing.

**[II.]--PENDING APPLICATIONS AND ABANDONED APPLICATIONS NOT REFERRED TO IN ISSUED PATENT**

In these cases, request for inspection or copies should be supported by a showing of reasons why they are desired. In the case of litigants,<sup>n1</sup> such a showing would consist of a certificate of the court where the suit is pending stating the relevancy and materiality of the information sought, together with proof of service upon the applicant of the papers,<sup>n2</sup> so that he can oppose the request for access. Instead of proof of service, some attorneys send two copies of the petition to the Patent and Trademark Office, the Office then sending one copy to the applicant.

Where the application has been abandoned for a long time, service upon the attorney of record is not sufficient, and notice must be given to the applicant and assignee as well as to the attorney of record. Such notice is similar to the notices of interference.<sup>n3</sup>

It is not the practice of the Patent and Trademark Office, where a right is established to access to a pending or abandoned application, to carve out only such portions of the application that are specified by the applicant thereof to be relevant to the issues.<sup>n4</sup> But note the right of a party in an interference to file certified copies of only those parts of the application that include only the interfering matter under Rule 241, *infra*.

Access to the prosecution of the application to which reference is made will be refused unless a showing is made why access is desired, and the reasons the petitioner therefor desires access. In such a circumstance, since only the original disclosure of the application is incorporated in the patent, there is no reason for access to the remainder.<sup>n5</sup>

**[III.]--ABANDONED APPLICATIONS REFERRED TO IN ISSUED FOREIGN PATENTS**

This situation arose in *In re Campbell & McCune*,<sup>n6</sup> where the abandoned application was referred to in an issued Canadian application. The petitioner relied upon 15 U.S.C. 1151-1157, relating to the maintenance within the Department of Commerce of a clearing house for the collection and dissemination of scientific, technical, and engineering information, as justifying access. It was the petitioner's position that the fact situation was covered by the language of Section 122 reading: "unless necessary to carry out the provisions of any Act of Congress ...," and that "the Act of Congress, codified as 15 U.S.C. Sections 1151-1157, is the necessary basis for petitioner's access." The Commissioner reviewed the two statutes and denied access, holding that 35 U.S.C. 122 governed the matter.<sup>n7</sup>

**[14.15]--Power to inspect: Length of time for which recognized.**

"An unrestricted power to inspect given by an applicant is, under existing practice, recognized as good until and unless rescinded. The same is true in the case of one given by the attorney or assignee so long as such attorney or assignee retains his or her connection with the application.

"Permission to inspect given by the Commissioner, however, is not of a continuing nature, since the conditions that justified the permit to inspect when given may not obtain at a later date."<sup>n1</sup>

**[14.16]--Manuscript decision.**

Section 707.06 of the Manual of Patent Examining Procedure (5th Ed., 13th Rev.) states:

"In citing court decisions, the USPQ citation should be given and, when it is convenient to do so, the U.S., C.C.P.A. or Federal Reporter citation should also be provided.

"The citation of manuscript decisions which are not available to the public should be avoided.

"It is important to recognize that a Federal District Court decision that has been reversed on appeal cannot be cited as authority.

"In citing a manuscript decision which is available to the public but which has not been published, the tribunal rendering the decision and complete data identifying the paper should be given. Thus, a decision of the Board of Patent Appeals and Interferences which has not been published but which is available to the public in the patented file should be cited as 'Ex-parte ..., decision of the Board of Patent Appeals and Interferences, Patent No. \_\_\_\_\_, paper No. \_\_\_\_\_, \_\_\_\_\_ pages.'

"Decisions found only in patented files should be cited only when there is no published decision on the same point.

"When a Commissioner's order, notice or memorandum not yet incorporated into this manual is cited in any official action, the title and date of the order, notice or memorandum should be given. When appropriate other data, such as a specific issue of the *Journal of the Patent Office Society* or of the *Official Gazette* in which the same may be found, should also be given."

Manuscript decisions in inaccessible files may be cited in support of some contention of law if this can be done without disclosing the invention of the case in which it was rendered in order to appreciate the pertinence of the decision to the matter under consideration.<sup>n2</sup> Commissioner's Order No. 1370<sup>n3</sup> provides that when examiners cite manuscript decisions, they shall quote the salient portions of such decisions or give the substance of them.

Unless the application in which the manuscript decision was rendered has matured into a patent, it is improper for the Examiner to refer to it in his Statement.<sup>n4</sup>

**[14.17]--Secrecy upon appeal to the Federal Circuit.**

Federal Circuit rule 11(d) states: "*Preservation of Protective Order on Appeal.* Material contained in the record on appeal which is subject to a protective order issued by the trial court, or an administrative agency, shall remain subject to that order, unless this court, on motion, amends, modifies, or annuls the order."

Federal Circuit rule 11(e) states: "*In Camera Proceeding.* In a proper case, where the interests of justice require, and upon a convincing showing thereof by motion properly made, the court will sit in camera or may seal its record, or both."

Rule 12(i) of the Federal Circuit deals with the preparation of confidential segments of appendices and their non-availability to the public and Rule 13(h) deals with briefs containing material subject to a protective order.

Rule 1(3) of the predecessor C.C.P.A. provided:

"The clerk shall furnish to *any applicant* a copy of any paper on file in any case on payment of the legal fees therefor." (Emphasis added.)

"Any applicant" in the Court of Customs and Patent Appeals Rule 1(3) was held in *In re Mosher* to refer to any member of the public who applies to the clerk. The words are equivalent to "any person." Rule 1(3) must be read in the light of Rule 1(1); and Rule 1(1) is coextensive with Rule 1(3). Thus, any member of the public was entitled to obtain a copy of the Board discussions as set forth in the record filed in a patent appeal before the Court of Customs and Patent Appeals and it was immaterial that the appeal was pending before the court and had not yet been heard.<sup>n1</sup>

**[14.18]--Practice with Atomic Energy applications.**

In view of the absolute time limit of thirty days specified in 42 U.S.C. 2182 (Section 152 of the Atomic Energy Act of 1954) the Patent and Trademark Office has adopted a policy of giving applicants advance notice before making a formal requirement, so as to give applicant ample time to take care of possible situations in which the statement could not be filed in thirty days or to submit any relevant matter for consideration.<sup>n1</sup> The question of the ownership of the intervention cannot be considered on applicant's petition that a statement under 42 U.S.C. § 2182 not be required.<sup>n2</sup>

The statement required by 42 U.S.C. § 2457(e) (dealing with NASA inventions and a similar provision to Section 152 of the Atomic Energy Act, 42 U.S.C. § 2182) must provide:

- (a) "the relationship (if any) of such invention to the performance of any work" under a government contact and
- (b) "the full facts concerning the circumstance under which such invention was made."<sup>n3</sup>

**FORMS:** See the \* Volume to this Treatise, Form 9-5, for a form for making a Declaration under Section 152 of the Atomic Energy Act.

Former Section 108 of the M.P.E.P. (5th Ed., 13th Rev.) pointed out that:

"In considering applications under the terms of 37 CFR 1.14(c), the relation of the subject matter to national security under § 107.01 is not a significant factor. EVEN applications using a well-known radio active source for any purpose or which disclose inventions having special relation to atomic energy MUST BE SUBMITTED TO Group 220. See § 706.03(b)."

#### **[I.]—Test For Patentability of Inventions Utilizing Atomic Energy.**

The proper test under 42 U.S.C. 2181(a) is whether the invention is useful *solely* in the utilization of atomic energy in an atomic weapon. The definition of "atomic weapon" is in 42 U.S.C. 2014(d). Even though an invention meets that definition, it is necessary to determine whether the invention is "useful solely" in atomic weapons. Thus, the restrictions of Section 2181(a) are not applicable where the invention has nonweapon utility.<sup>n4</sup>

#### **[14.19]—Status as to applications identified by serial number in a publication.**

Information will be given as to the pendency, abandonment, or patent number of any U.S. application identified by serial number in a U.S. or foreign patent.<sup>n1</sup> A written request for such information must be made, and must identify the source (the U.S. or foreign patent) by country and number.

#### **[I.]—INFORMATION AS TO STATUS OF AN APPLICATION**

Section 102 of the MPEP (5th Ed., 13th Rev.) discusses this as follows:

\* \* \* \* \*

##### **"PATENTED**

"If an application on which status information is requested has matured into a patent, the fact that the application is patented and the patent number, issue date and classification relative to the application may be given to anyone."

##### **"PENDING OR ABANDONED, NO REFERENCE**

"If an application is in pending or abandoned status and has not been referred to by number and date in a United States or foreign patent or printed application, status information indicating only that the application is pending or abandoned may be given only to Patent and Trademark Office employees and parties of record such as:

- "(a) The applicant.
- "(b) The attorney or agent *of record* in the application.
- "(c) The assignee *of record* in the Patent and Trademark Office.
- "(d) Anyone who has and furnishes written authority from a, b, or c."

##### **"REFERENCED APPLICATION**

"If an application has been referred to by number and date in a United States or foreign patent or published application, status information may be given to Patent and Trademark Office employees and to anyone who furnishes

## Patent Office Rules and Practice Rule 14

the Patent and Trademark Office with a written request citing the application in question by serial number and date of filing. The source document (a United States or foreign patent or published application) must be identified in the written request by the country, number and date of such patent or application."

See § 14.11 Abandoned applications. Referred to in issued patent.

**"REFERENCED APPLICATION, SOURCE DOCUMENT NOT PRESENTED**

"If a written request for status information is presented without a copy of the source document, Patent and Trademark Office employees will check to see that the source document and the application in question are properly identified and that the source document refers to the application in question before supplying the status information. Requests for information not accompanied with a copy of the source document may require the Office to obtain a copy of the source document for verification before status information can be supplied. This may result in some delay before the desired status information can be forwarded to the requester.

**"REFERENCED APPLICATION, SOURCE DOCUMENT PRESENTED**

"If a copy of the source document is presented, the Office will verify that the United States application in question is cited therein. After checking, status information may be immediately given and the source document copy may be returned to the requestor. In either case, at the time the status information is supplied, the person supplying the status information marks the request 'Information furnished', the date and his or her name. The request is then placed in the file wrapper or forwarded to the appropriate area (group art unit, abandoned files, etc.) for inclusion in the file wrapper as part of the official record of the application. The applicant is not consulted. See MPEP § 203.08"

\* \* \* \* \*

**"CONFIDENTIAL NATURE OF THE INTERNATIONAL APPLICATION.**

Section 110 of the M.P.E.P. (5th Ed., 13th Rev.) deals with this and states:

\* \* \* \* \*

"37 CFR 1.14(a) relating to access to international applications is found in MPEP § 101.

"Although most international applications are published soon after the expiration of 18 months from the priority date, PCT Article 21(2)(a), such publication does not open up the Home Copy or Search Copy to the public for inspection."n1

**[14.20]--Access to petition for institution of public use proceeding.**

In one case,n1 with respect to a petition for access to a petition for institution of public use proceedings previously held for a patent, the Solicitor pointed out that access to a petition for institution of public use proceedings and related papers is not within purview of 35 U.S.C. 122 and implementing Patent Rule 14. Access is not matter of right under Rule 11(a). Petitions and related papers, that are retained in file separate from patent's file wrapper history, are not part of Rule 11(a)'s "all papers relating to the case in the file of the patent." Accordingly, a petition for access is treated under Rule 182 as a case not specifically provided for. The Solicitor pointed out that public policy dictates that any member of the public is entitled to see the prosecution of patented subject matter. Accordingly, the Solicitor held that a petition for institution of public use proceedings and related papers constitutes part of the patented subject matter's prosecution history even though they are not physically present in Patent Rule 11(a)'s "file of the patent." Accordingly, in furtherance of the policy stated in *In re Hoffman*,n2 where the petition of access was granted, "... public policy dictates that any member of the public is entitled to see the prosecution of the patented subject matter ...."

**[14.21]--Pending and abandoned applications: Secrecy not impaired by Freedom of Information Act.**

Abandoned applications are not producible under the Freedom of Information Act as 35 U.S.C. § 122 is a specific statutory exemption from disclosure within the meaning of FOIA n1

In *Irons & Sears v. Dann*,n2 the Court of Appeals for the District of Columbia found 35 U.S.C. 122n3 to be a statute that:

"(1) affirmatively requires nondisclosure (2) of rather particular sorts of material (3) subject only to a discretionary but apparently narrow 'special circumstances' exception which (4) has not historically been used to permit anything

resembling general access to the materials in suit and (5) could not be so used without doing violence to the statutory scheme."

In the judgement of the court, these factors are precisely the sorts of factors upon which Congress intended the application of Exemption 3, 5 U.S.C. 522(b)(3)n4 to turn. On this basis, the court found that the request seeking PTO decisions granting or denying petitions for earlier filing dates related to pending or abandoned applications exempt from FOIA.n5 In a later case, the same court affirmed that 35 U.S.C. 122 unambiguously provides that applications for patents shall be kept in confidence by the PTO, and that no information concerning the same shall be disclosed, thereby bringing such information within Exemption 3.n6

**[14.22]--Applications kept secret because of national security.**

In accordance with 35 U.S.C. § 181, the Commissioner of Patents and Trademarks is authorized, upon the recommendation of a specified federal agency, to withhold the grant of a patent and to order that an invention be kept secret in the interest of national security. 35 U.S.C. § 183 provides a remedy for a patent owner affected by a secrecy order. This section provides, *inter alia*, that the owner of a patent which has been issued upon an application that was subject to a secrecy order may " \* \* \* bring suit in the Court of Claims [now the U.S. Claims Court, see Pub. L. No. 97-164, 96 Stat. 25 (Apr. 2, 1982)] for just compensation for the damage caused by reason of the order of secrecy \* \* \*." 35 U.S.C. § 183.n1

**[I.]--COMPENSATION BECAUSE OF SECRECY ORDER**

As to the question of proof required for recovery under the statute, the court noted, on the basis of the legislative history:

"We think the consensus at the hearings was that neither the courts nor the administrative agencies would permit purely speculative damages, but that there would have to be 'real concrete evidence of damage,' \* \* \*, 'actual damages' \* \* \*, 'proven damages,' \* \* \*, or 'perhaps a greater degree of proof or ability to prove damages.'"n2

Litigation expenses, attorney's fees or other expenses incurred in contesting the imposition of the secrecy order are not recoverable under 35 U.S.C. 183.n3

**FOOTNOTES:**

(n1) Footnote 1. See former Section 108 of the Manual of Patent Examining Procedure (5th Ed., 13th Rev.) (which section pointed out that the Examiner will submit even applications using a well-known radioactive source for any purpose, or which disclose inventions having special relation to atomic energy to review by the security division of the Patent and Trademark Office (Group 220)). The term "atomic energy" is defined as all forms of energy released in the course of nuclear fission or nuclear transformation (42 U.S.C. 2014(c)).

(n2) Footnote 1. See *infra*, Patent Office Rules Book, C.F.R. section, for current text of 37 C.F.R., Part 5.

(n3) Footnote 1.1. *Beckman Instruments, Inc. v. Coleman Instruments, Inc.*, 338 F.2d 573, 143 U.S.P.Q. 278 (7th Cir. 1964).

(n4) Footnote 2. In addition to the discussion below, the comments on the foreign filing license and related forms in Volume \*\*, Chap 22 *infra*, should be consulted.

(n5) Footnote 3. *Ex parte Glines*, 159 U.S.P.Q. 181,182 (Pat. and Trademark Office Bd. App. 1968).

(n6) Footnote 4. *In re Gaertner*, 604 F.2d 1348, 202 U.S.P.Q. 714 (C.C.P.A. 1979).

(n7) Footnote 5. *In re Gaertner*, 604 F.2d 1348, 202 U.S.P.Q. 714 (C.C.P.A. 1979).

(n8) Footnote 6. *In re Gaertner*, 604 F.2d 1348, 202 U.S.P.Q. 714 (C.C.P.A. 1979).

(n9) Footnote 7. *Pillsbury Co. v. General Mills, Inc.*, 252 F. Supp. 747, 148 U.S.P.Q. 487 (D. Minn. 1966), *rev'd*, *General Mills, Inc. v. Pillsbury Co.*, 378 F.2d 666, 154 U.S.P.Q. 207 (8th Cir. 1967).

(n10) Footnote 8. *In re Gaertner*, 604 f.2d 1348, 202 U.S.P.Q. 714 (C.C.P.A. 1979).

(n11) Footnote 9. *Thermovac Indus. Corp. v. Virtis Co.*, 285 F. Supp. 113, 158 U.S.P.Q. 558 (S.D.N.Y. 1968).

(n12) Footnote 10. *Beckman Instruments, Inc. v. Coleman Instruments, Inc.*, 338 F.2d 573, 143 U.S.P.Q. 278 (7th Cir. 1964); *Minnesota Mining & Mfg. Co. v. Norton Co.*, 153 U.S.P.Q. 449 (N.D. Ohio 1967).

(n13) Footnote 11. 144 U.S.P.Q. 272 (N.D. Ohio 1965).

(n14) Footnote 12. *In re Gaertner*, 604 F.2d 1348, 202 U.S.P.Q. 714 (C.C.P.A. 1979).

(n15) Footnote 13. *In re Gaertner*, 604 F.2d 1348, 1353, 202 U.S.P.Q. 714 (C.C.P.A. 1979). In this case, the C.C.P.A. held that:

"Gaertner's CIP declaration admits that earlier filed foreign counterparts of the CIP disclose 'subject matter' not found in his parent. In holding invalid under 35 USC 185 a patent issued on a CIP application containing a similar declaration, the Court of Appeals for the Seventh Circuit made no reference to an examination of the actual disclosures involved. *Beckman Instruments, Inc. v. Coleman Instruments, Inc.*, [143 U.S.P.Q. 279 (7th Cir. 1964)]. Gaertner's declaration is highly probative of the relationship between contents of his applications. We do not, however, rest our decision solely on that admission.

"Example 6 in the CIP, and in its foreign counterparts, teaches use of the reactant di(2-chloropropyl) phosphite not expressly disclosed in the parent. That compound per se is old and well-known. Although the product obtained in Example 6 and claimed in claim 9 is within the class of compounds recited in claim 1, the parent gives no express indication of using di(2-chloropropyl) phosphite.

"The process steps disclosed in Example 6, though corresponding with the general preparation method recited in the parent differ in several respects from those set forth in Examples 1 through 5 of the parent. In Example 6, the aliphatic phosphite diester is added to the glycinate-formaldehyde reaction product after the methanol solvent is removed. In the parent, that addition occurs while methanol is in solution. Example 6 proposes a relatively low temperature rotary evaporation technique for separating the methanol solvent whereas the parent uses a relatively high temperature distillation process to achieve separation. The oil product is obtained in Example 6 by concentrating solution in a rotary evaporator starting at less than 20 [degrees] C and up to 100 [degrees] C. The oil product in the parent is obtained by heating solution at about 115 [degrees] C for one hour and then cooling. Example 6 teaches the addition of HCL and use of an anhydrous sodium sulfate drying process; neither is taught or disclosed in the parent. Apart from a general allegation that evaporation is an old and well-known separation technique, Gaertner makes no attempt to explain the many differences between the process steps set forth in Example 6 and those described in the parent."

(n16) Footnote 14. *Sealelectro Corp. v. L.V.C. Indus., Inc.*, 271 F. Supp. 835, 153 U.S.P.Q. 610 (E.D.N.Y. 1967).

(n17) Footnote 15. *Beckman Instruments, Inc. v. Coleman Instruments, Inc.*, 338 F.2d 573, 143 U.S.P.Q. 278 (7th Cir. 1964).

(n18) Footnote 16. *Blake v. Bassick Co.*, 146 U.S.P.Q. 157 (N.D. Ill. 1963).

(n19) Footnote 17. *Beckman Instruments, Inc. v. Coleman Instruments, Inc.*, 338 F.2d 573, 143 U.S.P.Q. 278 (7th Cir. 1964); *Minnesota Mining & Mfg. Co. v. Norton Co.*, 153 U.S.P.Q. 449 (N.D. Ohio 1967).

(n20) Footnote 18. *Blake v. Bassick Co.*, 245 F. Supp. 635, 146 U.S.P.Q. 160 (N.D. Ill. 1963).

(n21) Footnote 19. 429 F. Supp. 914, 195 U.S.P.Q. 59 (W.D. Pa. 1977).

(n22) Footnote 20. 604 F.2d 1348, 202 U.S.P.Q. 714 (C.C.P.A. 1979).

(n23) Footnote 21. 429 F. Supp. 914, 195 U.S.P.Q. 59 (W.D. Pa. 1977).

(n24) Footnote 22. 338 F.2d 573, 143 U.S.P.Q. 278 (7th Cir. 1964).

(n25) Footnote 23. *In re Gaertner*, 604 F.2d 1348, 202 U.S.P.Q. 714 (C.C.P.A. 1979).

(n26) Footnote 24. 487 F. Supp. 885, 205 U.S.P.Q. 799 (D. Mass. 1980), *aff'd*, 649 F.2d 871, 210 U.S.P.Q. 799 (1st Cir. 1981).

(n27) Footnote 25. *Shelco, Inc. v. Dow Chem. Co.*, 322 F. Supp. 485, 168 U.S.P.Q. 395 (N.D. Ill. 1970); *aff'd*, 466 F.2d 613, 173 U.S.P.Q. 451 (7th Cir.); *cert. denied*, 409 U.S. 876, 175 U.S.P.Q. 385 (1972); *Ross v. McQuay, Inc.*, 257 F. Supp. 14, 150 U.S.P.Q. 510 (D. Minn. 1966) (and cases cited therein).



(n28) Footnote 26. *Minnesota Mining & Mfg. Co. v. Norton Co.*, 240 F. Supp. 150, 145 U.S.P.Q. 81 (N.D. Ohio 1965).

(n29) Footnote 27. *Minnesota Mining & Mfg. Co. v. Norton Co.*, 366 F.2d 238, 151 U.S.P.Q. 1 (6th Cir. 1966); *cert. denied*, 385 U.S. 1005, 152 U.S.P.Q. 844 (1967).

(n30) Footnote 28. *Minnesota Mining & Mfg. Co. v. Norton Co.*, 240 F. Supp. 150, 145 U.S.P.Q. 81 (N.D. Ohio 1965), *rev'd*, 366 F.2d 238, 151 U.S.P.Q. 1 (6th Cir. 1966); *cert denied*, 385 U.S. 1005, 152 U.S.P.Q. 844 (1967). In *Minnesota Mining*, the patentee's counsel became aware of improper foreign filings during the course of infringement litigation, and applied to the Commissioner for retroactive licensing at approximately the same time that its adversary moved for summary judgment on the patent's invalidity under 35 U.S.C. 185. Before the Commissioner rendered a decision on the patentee's retroactive licensing application, the District Court granted summary judgment, holding the patent in question to be invalid. That action was affirmed by the District Court upon reconsideration of the motion after the Commissioner had subsequently granted the retroactive license. The District Court took the view that the Commissioner's licensing could have no effect upon the clear invalidity of the patent during the pendency of the litigation, or indeed, at any time after the invalid patent had issued. The Sixth Circuit reversed, holding, *inter alia*, that the grant of a retroactive license at any time cures the patent's invalidating defect as of the date of the foreign filing to which the license is directed.

(n31) Footnote 29. *Minnesota Mining & Mfg. Co. v. Norton Co.*, 240 F. Supp. 150, 145 U.S.P.Q. 81 (N.D. Ohio 1965), *rev'd*, 366 F.2d 238, 151 U.S.P.Q. 1 (6th Cir. 1966), *cert. denied*, 385 U.S. 1005, 152 U.S.P.Q. 844 (1967).

(n32) Footnote 30. *Pillsbury Co. v. General Mills, Inc.*, 252 F. Supp. 747, 148 U.S.P.Q. 487 (D. Minn. 1966), *rev'd*, *General Mills, Inc. v. Pillsbury Co.*, 378 F.2d 666, 154 U.S.P.Q. 207 (8th Cir. 1967).

(n33) Footnote 31. *Pillsbury Co. v. General Mills, Inc.*, 252 F. Supp. 747, 148 U.S.P.Q. 487 (D. Minn. 1966), *rev'd*, *General Mills, Inc. v. Pillsbury Co.*, 378 F.2d 666, 154 U.S.P.Q. 207 (8th Cir. 1967).

(n34) Footnote 32. *Thermovac Indus. Corp. v. Virtis Co.*, 285 F. Supp. 113, 158 U.S.P.Q. 558 (S.D.N.Y. 1968); *Sealectro Corp. v. L.V.C. Indus., Inc.*, 271 F. Supp. 835, 153 U.S.P.Q. 610 (E.D.N.Y. 1967); *Minnesota Mining & Mfg. Co. v. Norton Co.*, 144 U.S.P.Q. 272 (N.D. Ohio 1965).

(N35) Footnote 33. See 366 F. 2d 238, 151 U.S.P.Q. 1 (6th Cir. 1966).

(n36) Footnote 34. *Sun Rubber Co. v. Mattel, Inc.*, 263 F. Supp. 287, 152 U.S.P.Q. 786 (C.D. Cal. 1966); *Ross v. McQuay, Inc.*, 257 F. Supp. 14, 150 U.S.P.Q. 510 (D. Minn. 1966); *McCormick v. Brenner*, 146 U.S.P.Q. 340 (D.D.C. 1965); *Blake v. Bassick Co.*, 146 U.S.P.Q. 157 (N.D. Ill. 1965); *Pillsbury Co. v. Brenner*, 146 U.S.P.Q. 99 (D.D.C. 1965).

(n37) Footnote 35. *Thermovac Indus. Corp. v. Virtis Co.*, 159 U.S.P.Q. 345 (S.D.N.Y. 1968).

(n38) Footnote 36. *Minnesota Mining & Mfg. Co. v. Norton Co.*, 153 U.S.P.Q. 449 (N.D. Ohio 1966).

(n39) Footnote 37. *Iron Ore Co. of Canada v. Dow Chem. Co.*, 177 U.S.P.Q. 34 (D. Utah 1972); *amended*, 177 U.S.P.Q. 447 (D. Utah 1973).

(n40) Footnote 38. *Reese v. Dann*, 391 F. Supp. 12, 185 U.S.P.Q. 492 (D.D.C. 1975).

(n41) Footnote 39. *Kelley Mfg. Co. v. Lilliston Corp.*, 180 U.S.P.Q. 364 (E.D.N.C. 1973).

(n42) Footnote 40. *Torin Corp. v. Philips Indus., Inc.*, 89 F. R. D. 346, 212 U.S.P.Q. 503 (S.D. Ohio 1981).

(n43) Footnote 41. *Torin Corp. v. Philips Indus., Inc.*, 89 F.R.D. 346, 212 U.S.P.Q. 503 (S.D. Ohio 1981).

(n44) Footnote 42. *Blake v. Bassick Co.*, 146 U.S.P.Q. 157 (N.D. Ill. 1965).

(n45) Footnote 43. *Beckman Instruments, Inc. v. Coleman Instruments, Inc.*, 338 F. 2d 573, 143 U.S.P.Q. 278 (7th Cir. 1964).

(n46) Footnote 44. *In re Application Filed Nov. 22, 1952*, 153 U.S.P.Q. 410 (Comm'r Pat. and Trademarks 1967).

(n47) Footnote 45. 146 U.S.P.Q. 157 (N.D. Ill. 1965).

(n48) Footnote 46. *Spound v. Mohasco Indus., Inc.*, 186 U.S.P.Q. 183 (D. Mass. 1975), *aff'd*, 534 F.2d 404, 190 U.S.P.Q. 1 (1st Cir.), *cert. denied*, 429 U.S. 886, 191 U.S.P.Q. 407, *reh'g denied*, 429 U.S. 988 (1976).

## Patent Office Rules and Practice Rule 14

(n49) Footnote 47. *In re Application Filed Nov. 22, 1952*, 153 U.S.P.Q. 410 (Comm'r Pat. and Trademarks 1967).

(n50) Footnote 48. *In re Deskey & Lurkis*, 157 U.S.P.Q. 352 (Comm'r Pat. and Trademarks 1967).

(n51) Footnote 49. *In re Sternau*, 149 U.S.P.Q. 70 (Comm'r Pat. and Trademarks 1966).

(n52) Footnote 50. *In re Application filed November 22, 1952*, 837 O.G. 1046 (Comm'r).

(n53) Footnote 51. In *Beckman Instruments Inc., v. Coleman Instruments, Inc.*, 338 F.2d 573, 143 U.S.P.Q. 278 (7th Cir. 1964), the Seventh Circuit held that the disclosure of a later application differed materially from that of an earlier one, and that accordingly the fact that the earlier case had been pending for more than six months when the foreign applications were filed did not obviate the requirement for a license.

(n54) Footnote 52. 1042 O.G. 3-10.

(n55) Footnote 53. *In re Application filed November 22, 1952*, 837 O.G. 1046, 153 U.S.P.Q. 410 (Comm'r Pat. and Trademarks 1967).

(n56) Footnote 54. This practice began May 3, 1965.

(n57) Footnote 1. *Misegades & Douglas v. Schuyler*, 328 F. Supp. 619, 170 U.S.P.Q. 128 (E.D. Va. 1971), appeal dismissed, 456 F.2d 255, 172 U.S.P.Q. 577 (4th Cir. 1972). See also Manual of Patent Examining Procedure, § 101.

(n58) Footnote 2. See Sections 101 and 102 of the Manual of Patent Examining Procedure.

(n59) Footnote 1. Manual of Patent Examining Procedure, § 104.

(n60) Footnote 2. The right to inspect includes the right to make copies and to obtain certified copies. *Classen v. Steffen*, 1904 C.D. 573. But the better practice is to include the right to make copies.

(n61) Footnote 3. **Order No. 1271**, March 27, 1899. *Parties Who May Have Access to Application Files*. Hereafter no person except the applicant, the assignee, whose assignment is of record, or the attorney of record will be permitted to have access to the file of any application, except as provided for under the interference rules, unless written authority from the applicant, assignee, or attorney, identifying the application to be inspected, is filed in the case to become a part of the record thereof, or upon the written order of the Commissioner, which will also become a part of the record of the case.

(n62) Footnote 4. Commissioner's Administrative Order No. 10, Dec. 16, 1946. *Approval of Power to Inspect*. [This Order supersedes Order 2345, Aug. 16, 1917.] Revised Aug. 28, 1952.

(n63) Footnote 5. 893 O.G. 810.

(n64) Footnote 6. See § 14.7, Power to inspect: Litigants and § 14.9, Threatening letters of applicant, *infra*.

(n65) Footnote 1. *Ex parte Baker*, 1889 C.D. 232 (Comm'r).

(n66) Footnote 2. *In re Kellogg Switchboard*, 1906 C.D. 274 (Comm'r) (overruling *Ex parte MacLaughlin*, 1891 C.D. 65 (Comm'r)).

(n67) Footnote 3. *In re Duncan & Duncan*, 1904 C.D. 79 (Comm'r).

(n68) Footnote 4. *Ex parte MacLaughlin*, 1891 C.D. 65 (Comm'r); Manual of Patent Examining Procedure, § 106.

(n69) Footnote 1. *Ex parte Harrison*, 1925 C.D. 123 (Comm'r).

(n70) Footnote 2. For distinction of assignment and grant, see Amdur, "Patent Law and Practice," 505.

See Manual of Patent Examining Procedure, § 106.01.

(n71) Footnote 1. *Ex parte Superior Brass*, 1925 C.D. 92 (Comm'r); cf. *In re National Railway*, 1907 C.D. 193 (Comm'r).

(n72) Footnote 2. See Amdur, "Patent Law and Practice," 514.

(n73) Footnote 3. *Ex parte Adam*, 1900 C.D. 106 (Comm'r).

(n74) Footnote 4. *Ex parte Adam*, 1900 C.D. 106 (Dec. Comm'r Pat.).

## Patent Office Rules and Practice Rule 14

(n75) Footnote 5. *Ex parte* Adam, 1900 C.D. 106 (Dec. Comm'r Pat.).

(n76) Footnote 6. *Ex parte* Superior Brass, 1925 C.D. 92 (Comm'r); cf. *In re* National Railway, 1907 C.D. 193 (Comm'r).

(n77) Footnote 7. Manual of Patent Examining Procedure, § 106.01.

(n78) Footnote 1. *In re* Standard Adding Mach., 1910 C.D. 195 (Comm'r).

(n79) Footnote 2. *Ex parte* Warner, 1901 C.D. 97; *Ex parte* Heard, 1905 C.D. 66; *In re* Brown, 1905 C.D. 71.

(n80) Footnote 3. *In re* Standard Adding Mach., 1910 C.D. 195 (Comm'r).

(n81) Footnote 4. *In re* Marvin Estate Co., 1909 C.D. 209 (Comm'r) (citing *Metropolitan Elevated v. Siemens*, 1898 C.D. 220 for the proposition that:

"Where an applicant relied upon his application as a means to interfere with a competitor's business or customers, permission to inspect the application may be given to the competitor by the Commissioner (*Ex Parte* Bonnie-B Co., 1923 C.D. 42; 313 O.G. 453)")

See Manual of Patent Examining Procedure, § 104.

(n82) Footnote 5. *In re* Davis Temperature Co., 1905 C.D. 47 (Comm'r).

(n83) Footnote 6. *In re* Gerard, 127 U.S.P.Q. 337 (Comm'r Pat. and Trademarks 1960).

(n84) Footnote 7. *In re* Marsh Eng'g Co., 1913 C.D. 183 (Comm'r).

(n85) Footnote 8. *In re* Marsh Eng'g Co., 1913 C.D. 183 (Dec. Comm'r Pat.).

(n86) Footnote 9. *In re* Marvin Estate Co., 1909 C.D. 209 (Comm'r).

(n87) Footnote 10. *In re* Doman, 1905 C.D. 101; *Ex parte* Lewis & Unger, 1903 C.D. 303; *Ex parte* Lanning, 1906 C.D. 412; *In re* Vacuum Specialty, 1909 C.D. 88.

(n88) Footnote 11. *In re* Application Filed April 28, 1951, 121 U.S.P.Q. 280 (Comm'r).

(n89) Footnote 12. *Electro-Sonic Labs, Inc. v. Grado*, 125 U.S.P.Q. 442 (S.D.N.Y. 1960).

(n90) Footnote 13. *In re* Nieden, 116 U.S.P.Q. 259 (Comm'r Pat. and Trademarks 1958).

(n91) Footnote 14. *Great Lakes Carbon Corp. v. Continental Oil Co.*, 23 F.R.D. 33, 120 U.S.P.Q. 28 (W.D. La. 1958).

(n92) Footnote 15. *Carrier Mfg. Co. v. Rex Chainbelt, Inc.*, 281 F. Supp. 717, 157 U.S.P.Q. 613 (E.D. Wis. 1968); *Ideal Toy Corp. v. Tyco Indus., Inc.*, 478 F. Supp. 1191, 204 U.S.P.Q. 17 (D. Del. 1979); *Crown Mach. & Tool Co. v. KVP-Sutherland Paper Co.*, 244 F. Supp. 543, 146 U.S.P.Q. 1 (N.D. Cal. 1965); *Paper Converting Mach. Co. v. Magna-Graphics Corp.* 207 U.S.P.Q. 1136 (E.D. Wis. 1980).

(n93) Footnote 16. *Celanese Corp. v. E. I. du Pont de Nemours & Co.*, 58 F.R.D. 606, 177 U.S.P.Q. 360 (D. Del. 1973); *Crown Mach. & Tool Co. v. KVP-Sutherland Paper Co.*, 244 F. Supp. 543, 146 U.S.P.Q. 1 (N.D. Cal. 1965); *Cleo Wrap Corp. v. Elsner Eng'g Works*, 59 F.R.D. 386, 176 U.S.P.Q. 266 (M.D. Pa. 1972); *Paper Converting Mach. Co. v. Magna-Graphics Corp.*, 207 U.S.P.Q. 1136 (E.D. Wis. 1980).

(n94) Footnote 17. *Ideal Toy Corp. v. Tyco Indus., Inc.*, 478 F. Supp. 1191, 204 U.S.P.Q. 17 (D. Del. 1979), (where the court examined how various other courts applied this standard).

(n95) Footnote 1. *Ex parte* Moore, 1927 C.D. 87 (Comm'r); cf. *In re* New York Woven Wire, 1906 C.D. 101; see also *In re Bom*, 193 U.S.P.Q. 188 (Solicitor 1976).

(n96) Footnote 2. *International Paper Co. v. Fibreboard Corp.*, 63 F.R.D. 88, 181 U.S.P.Q. 740 (D. Del. 1974).

The current practice is set forth in *In re Bom*, 193 U.S.P.Q. 190 (Comm'r 1976), where the petitioner requested the following four items:

## Patent Office Rules and Practice Rule 14

1 "the right to intervene in the \* \* \* reissue application for the purpose of bringing to the attention of the Examiner any and all facts, information, documents or art which petitioners believe relevant \* \* \* and to present arguments \* \* \* with respect thereto, all within a reasonable time, not less than two months, following the grant of access;"

2 "a moratorium on any other action in or further prosecution of said reissue application \* \* \* for such period of time;"

3 "copies of all actions, documents, and other papers taken by the \* \* \* Office or by the applicant \* \* \* be served upon the attorneys for petitioners;"

4 "that the attorneys for petitioners herein be informed in advance of any interview with the Examiner in charge of the \* \* \* reissue application \* \* \* and be granted the right to participate in any such interview \* \* \*."

The Commissioner ruled:

"Petitioners will be permitted to submit, in writing, within Two Months of the date of this decision, any facts, materials, prior art, etc., which they believe relevant to the examination of this reissue application. Any such materials submitted must indicate that copies thereof have been served on Counsel for reissue applicant. The relevance of any materials submitted by Petitioners to the examination of the reissue application must be clearly pointed out. If Petitioners consider that one or more of the claims pending in the reissue application are rendered unpatentable to reissue applicant by any of the materials or prior art which might be submitted, the particular claim or claims so affected must be pointed out. Any such submission must be accompanied by an indication of the current status of Civil Action No. B-75-213.

"Petitioners may anticipate, unless otherwise so notified, that any submission under the above guidelines will be made of record in the reissue application and considered by the Primary Examiner.

"Reissue Applicant may file, within Two Months of the date of any submission by Petitioners, any materials arguments, etc., considered appropriate in response to Petitioners' submission. Any such response by reissue applicant must indicate service on Petitioners and must also include an indication of the current status of Civil Action No. B-75-213.

"It is expected that the above noted submissions by either party will include any materials, including relevant portions of depositions, exhibits, etc. developed in Civil Action No. B-75-213 which would be *relevant* to the examination of the reissue application. It is emphasized that the office is interested in materials which are relevant, but is not interested in receiving materials which are *not* relevant to the examination of the reissue application.

"Insofar as the request for copies is concerned, Petitioners will, of course, receive a copy of any response by reissue applicant to Petitioners' submission, as noted above. The Office, however, will not undertake to sua sponte serve Petitioners with copies of actions by the Primary Examiner or ex parte amendments by reissue applicant. Petitioners are not, however, precluded from making appropriate arrangements with Counsel for reissue applicant to receive these materials, or otherwise obtaining them from the Office.

"The requests to 'be informed in advance of any interview with the Examiner' and to 'be granted the right to participate in any such interview' are hereby denied. While it is recognized that the original patent is involved in litigation, the examination of the reissue application remains essentially an ex parte matter. The Office will, of course, consider any materials submitted in accordance with the guidelines set forth above, but will not permit Petitioners to interview the Primary Examiner or otherwise have an oral hearing. See *Carey v. The New Home Sewing Machine Co.*, 1901 C.D. 165; 97 O.G. 1171. See, also, 37 CFR 1.181(e). Petitioners are, of course, under no obligation and cannot demand, as a matter of right, to participate in the examination of the reissue application. The choice of whether or not to participate in the manner set forth in this decision rests solely with Petitioners.

"The request for a 'moratorium on any other action in or further prosecution' is granted for such time, not more than TWO MONTHS, as required by Petitioners to file their submission, and for such additional time, not more than TWO MONTHS, as required by reissue applicant to respond thereto."

(n97) Footnote 3. *Dreznes v. Sebok*, 115 U.S.P.Q. 385 (Comm'r Pat. & Trademarks 1955).

(n98) Footnote 1. *Ex parte Bonnie-B Co.*, 1923 C.D. 42 (Comm'r).

(n99) Footnote 2. *Ex parte Bonnie-B Co.*, 1923 C.D. 42 (Comm'r Pat. & Trademarks).

## Patent Office Rules and Practice Rule 14

(n100) Footnote 3. *In re Application for Trimless Cabinets*, 128 U.S.P.Q. 95 (Comm'r Pat. & Trademarks 1960); *In re Crossman*, 187 U.S.P.Q. 367 (Solicitor 1975).

(n101) Footnote 1. *In re Commercial Mica*, 1907 C.D. 186 (Comm'r) (abandoned application).

(n102) Footnote 2. *Fleming v. Gardner*, 1916 C.D. 35 (Comm'r) (pending application).

(n103) Footnote 3. *In re Peabody & Co.*, 1912 C.D. 290 (Comm'r).

(n104) Footnote 4. *In re Dyer*, 1903 C.D. 365 (Comm'r); cf. *Ex parte Wixford*, 1906 C.D. 54; *In re Marsh Eng'g*, 1913 C.D. 183; see also *Crown Mach. & Tool Co. v. KVP-Sutherland Paper Co.*, 244 F. Supp. 543, 146 U.S.P.Q. 1 (N.D. Cal. 1965).

(n105) Footnote 5. *In re Dyer*, 1903 C.D. 365 (Dec. Comm'r Pat.); cf. *Ex Parte Wixford*, 1906 C.D. 54 (Dec. Comm'r Pat.); *In re Marsh Eng'g*, 1913 C.D. 183. (Dec. Comm'r Pat.); see also *Crown Mach. & Tool Co. v. KVP Sutherland Paper Co.*, 244 F. Supp. 543, 146 U.S.P.Q. 2. (N.D. Cal. 1965).

(n106) Footnote 6. *In re Belle City Iron Co.*, 1906 C.D. 479 (pending).

(n107) Footnote 7. *In re Belle City Iron Co.*, 1906 C.D. 479 (Dec. Comm'r Pat.) (pending).

(n108) Footnote 8. *In re Doman*, 1905 C.D. 101 (abandoned).

(n109) Footnote 9. *Fleming v. Gardner*, 1916 C.D. 35.

(n110) Footnote 10. *In re Morton Co.*, 15 Gourick 9:29 (Comm'r, 1903) (abandoned).

See also § 14.19 *intra*.

(n111) Footnote 1. See § 14.10 *supra* (and cases cited therein at N. 97).

(n112) Footnote 2. *In re Yang* 177 U.S.P.Q. 88 (Solicitor 1973).

(n113) Footnote 3. *In re Yang*, 177 U.S.P.Q. 88 (Solicitor 1973).

(n114) Footnote 4. See § 14.10 *supra* (and cases cited therein at N. 99).

(n115) Footnote 1. *In re Doman*, 1905 C.D. 101 (Comm'r). In this case, the file wrapper was bare except for a statement that applicant had abandoned an earlier case that was identified. In the referred-to application, a number of claims were rejected on certain references from the patent office file. It would seem that the examiner had allowed the application without the citation of a single reference.

See also *In re Hoffman*, 129 U.S.P.Q. 185 (Comm'r Pat. & Trademarks 1961); *Rolls-Royce Ltd. v. United States*, 168 Ct. Cl. 367, 339 F.2d 654, 143 U.S.P.Q. 445 (1964).

(n116) Footnote 2. *Ex parte Lewis & Unger*, 1903 C.D. 303 (Comm'r); cf. *Ex parte Taylor*, 1905 C.D. 45; *Ex parte Britt*, 1905 C.D. 156.

(n117) Footnote 3. See Manual of Patent Examining Procedure, § 202.02 (6th ed., rev. 1).

(n118) Footnote 1. See § 14.8, 14.10 *supra*.

(n119) Footnote 2. *In re Dyer*, 1903 C.D. 365 (Comm'r); cf. *Ex parte Wixford*, 1906 C.D. 54; *In re Marsh Eng'g*, 1913 C.D. 183.

See also *Crown Mach. & Tool Co. v. KVP-Sutherland Paper Co.*, 244 F. Supp. 543, 146 U.S.P.Q. 1 (N.D. Cal. 1965).

(n120) Footnote 3. *In re Bullock Elec.*, 1907 C.D. 207 (Comm'r).

(n121) Footnote 4. *In re Marsh Eng'g*, 1913 C.D. 183 (Comm'r Pat. and Trademarks 1960).

(n122) Footnote 5. *In re Application Filed May 2, 1955*, 124 U.S.P.Q. 233 (Comm'r) (The language of the Commissioner in this case states: "Ordinarily the fact that a patent refers to an application is not, in itself, a sufficient reason for granting access"; however, in view of the Rule 14(b) the Commissioner was apparently alluding to access to the *prosecution* of the application in question.)

(n123) Footnote 6. 170 U.S.P.Q. 354 (Comm'r Pat. and Trademarks 1971).

## Patent Office Rules and Practice Rule 14

(n124) Footnote 7. *In re Campbell & McCune*, 170 U.S.P.Q. 354 (Dec. Comm'r Pat. 1971).

(n125) Footnote 1. See Section 104 of the Manual of Patent Examining Procedure (5th Ed., 13th Rev.).

(n126) Footnote 2. *Ex parte Morley*, 1902 C.D. 144 (Comm'r).

(n127) Footnote 3. September 11, 1900.

(n128) Footnote 4. *Ex parte Sullivan*, 57 U.S.P.Q. 151 (Pat. & Trademark Office Bd. App. 1943); see § 15.1 *infra*, Requests for identifiable records.

(n129) Footnote 1. *In re Mosher*, 45 C.C.P.A. 701, 248 F.2d 956, 115 U.S.P.Q. 140, 1958 C.D. 99 (1957).

(n130) Footnote 1. *In re Howard*, 1959 C.D. 2, 122 U.S.P.Q. 21 (Comm'r Pat. and Trademarks 1957).

(n131) Footnote 2. *In re Howard*, 122 U.S.P.Q. 21, 1959 C.D. 2 (Comm'r Pat. & Trademarks 1957).

(n132) Footnote 3. *Cadillac Gage Co. v. Brenner*, 124 App. D.C. 203, 363 F.2d 690, 150 U.S.P.Q. 12, 13 (1966).

(n133) Footnote 4. *In re Brueckner*, 623 F.2d 184, 206 U.S.P.Q. 415 (C.C.P.A. 1980).

(n134) Footnote 1. The **Notice of December 11, 1964** (858 O.G. 3) states:

"In view of the relatively long pendency of patent applications at the present time, the final disposition of which may, in some cases, be of substantial importance to the public in general or, at least, to persons other than the applicants, it has been decided effective immediately to advise any person who makes written request for information as to the status of a United States application referred to by number in a foreign patent, which patent is identified in the request, whether the application is pending, abandoned or patented and, if patented, what the patent number is. The former practice of giving similar information with respect to an application referred to by number in a United States patent (Manual of Patent Examining procedure, section 102) will be continued."

(n135) Footnote 1. See Patent Cooperation Treaty, June 19, 1970, article 30, reprinted in Appendix T to the M.P.E.P. in Volume 1C to this treatise (modified on Feb. 3, 1984).

(n136) Footnote 1. *In re Public Use Proceeding Bourne*, 191 U.S.P.Q. 255 (Solicitor 1976).

(n137) Footnote 2. *In re Hoffman*, 129 U.S.P.Q. 185 (Comm'r Pat. and Trademarks 1961).

(n138) Footnote 1. Exemption 3, 5 U.S.C. § 552(b)(3) (as amended in 1976); see *Lee Pharmaceuticals v. Kreps*, 577 F.2d 610, 198 U.S.P.Q. 601 (9th Cir. 1978), *cert. denied*, 439 U.S. 1073, 200 U.S.P.Q. 832 (1979).

(n139) Footnote 2. 196 App. D.C. 308, 606 F.2d 1215, 1221, 202 U.S.P.Q. 798 (1979), *cert. denied*, 444 U.S. 1075, 204 U.S.P.Q. 1060 (1980).

(n140) Footnote 3. 35 U.S.C. 122 states;

"Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner."

(n141) Footnote 4. Exemption 3 excludes from the coverage of FOIA matters that are:

"specifically exempted from disclosure by statute (other than section 552b of this title), provided that such statute (A) requires that the matters be withheld from the public in such a manner as to leave no discretion on the issue, or (B) establishes particular criteria for withholding or refers to particular types of matters to be withheld[.]"

The proviso that makes up the major part of this exemption was added in 1976 by the Government in the Sunshine Act, Pub. L. No. 94-409, 90 Stat. 1241, 1247 (1976). Previously, Exemption 3 simply shielded material "specifically exempted from disclosure by statute." 5 U.S.C. § 552(b)(3) (1970).

(n142) Footnote 5. *Irons & Sears v. Dann*, 196 App. D.C. 308, 606 F.2d 1215, 202 U.S.P.Q. 798 (1979) *cert. denied*, 444 U.S. 1075, 204 U.S.P.Q. 1060 (1980).

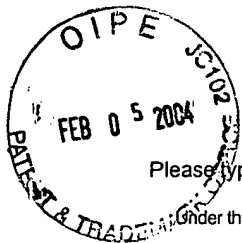
(n143) Footnote 6. *Irons v. Diamond* 216 App. D.C. 107, 670 F.2d 265, 214 U.S.P.Q. 81 (1981).

## Patent Office Rules and Practice Rule 14

(n144) Footnote 1. *Constant v. United States*, 233 Ct. Cl. 148, 617 F.2d 239, 206 U.S.P.Q. 313 (1980); see also *Constant v. United States*, 1 Ct. Cl. 600, 216 U.S.P.Q. 505 (1982) *aff'd without opinion*, 714 F.2d 162 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1041 (1984), *reh'g denied*, 465 U.S. 1074 (1984).

(n145) Footnote 2. *Constant v. United States*, 223 Ct. Cl. 148, 617 F.2d 239, 244, 206 U.S.P.Q. 313, (1980); see also *Constant v. United States*, 1 Ct. Cl. 600, 216 U.S.P.Q. 505 (1982), *aff'd without opinion*, 714 F.2d 162 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1041 (1984), *reh'g denied*, 465 U.S. 1074 (1984).

(n146) Footnote 3. *Constant v. United States*, 1 Ct. Cl. 600, 216 U.S.P.Q. 505 (1982), *aff'd without opinion*, 714 F.2d 162 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1041 (1984), *reh'g denied*, 465 U.S. 1074 (1984).



02-06-10038

DAE

Please type a plus sign (+) inside this box → ☒

PTO/SB/21 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

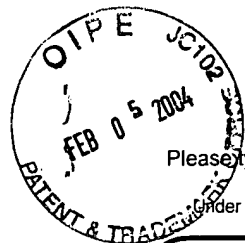
<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/489,760	
	Filing Date	January 21, 2000	
	First Named Inventor	Goulmy et al.	
	Group Art Unit	1644	
	Examiner Name	P. Huynh	
		Attorney Docket Number	2183-4285US

<b>ENCLOSURES (check all that apply)</b>		
<input checked="" type="checkbox"/> Postcard receipt acknowledgment (attached to the front of this transmittal)	<input type="checkbox"/> Information Disclosure Statement, PTO/SB/08A; <input type="checkbox"/> copy of cited references	<input type="checkbox"/> Terminal Disclaimer
<input checked="" type="checkbox"/> Duplicate copy of this transmittal sheet in the event that additional filing fees are required under 37 C.F.R. § 1.16	<input type="checkbox"/> Supplemental Information Disclosure Statement; PTO/SB/08A; copy of cited references and Check No. in the amount of \$180.00	<input type="checkbox"/> Terminal Disclaimer
<input type="checkbox"/> Preliminary Amendment	<input type="checkbox"/> Associate Power of Attorney	<input type="checkbox"/> Terminal Disclaimer
<input type="checkbox"/> Response to Restriction Requirement/Election of Species Requirement dated	<input type="checkbox"/> Petition for Extension of Time and Check No. in the amount of \$	
<input type="checkbox"/> Amendment in response to office action dated	<input type="checkbox"/> Petition	
<input type="checkbox"/> Amendment under 37 C.F.R. § 1.116 in response to final office action dated	<input checked="" type="checkbox"/> Fee Transmittal Form	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Additional claims fee - Check No. in the amount of \$	<input type="checkbox"/> Certified Copy of Priority Document(s)	<b>PETITION FOR A RETROACTIVE LICENSE UNDER 35 U.S.C. § 184</b> with attached Declaration of Donald F. Hunt; Lexstat 1-I Patent Office Rules and Practice Rule 14
<input type="checkbox"/> Letter to Chief Draftsman and copy of FIGS. with changes made in red	<input type="checkbox"/> Assignment Papers (for an Application)	
<input type="checkbox"/> Transmittal of Formal Drawings	Remarks	
<input type="checkbox"/> Formal Drawings ( sheets)	<b>The Commissioner is authorized to charge any additional fees required but not submitted with any document or request requiring fee payment under 37 C.F.R. §§ 1.16 and 1.17 to Deposit Account 20-1469 during pendency of this application.</b>	

<b>SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT</b>		
Firm or Individual name	G. Scott Dorland, Ph.D.	Registration No. 51,622
Signature		
Date	February 5, 2004	

<b>CERTIFICATE OF MAILING</b>	
Express Mail Label Number: <u>EV326919482US</u>	
Date of Deposit: <u>February 5, 2004</u>	
Person Making Deposit: <u>Christopher Haughton</u>	





Please type a plus sign (+) inside this box → ☐

PTO/SB/21 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/489,760
Filing Date	January 21, 2000
First Named Inventor	Goulmy et al.
Group Art Unit	1644
Examiner Name	P. Huynh
Attorney Docket Number	2183-4285US

### ENCLOSURES (check all that apply)

- ☒ Postcard receipt acknowledgment (attached to the front of this transmittal)
- ☒ Duplicate copy of this transmittal sheet in the event that additional filing fees are required under 37 C.F.R. § 1.16
- ☐ Preliminary Amendment
- ☐ Response to Restriction Requirement/Election of Species Requirement dated
- ☐ Amendment in response to office action dated
- ☐ Amendment under 37 C.F.R. § 1.116 in response to final office action dated
- ☐ Additional claims fee - Check No. in the amount of \$
- ☐ Letter to Chief Draftsman and copy of FIGS. with changes made in red
- ☐ Transmittal of Formal Drawings
- ☐ Formal Drawings ( sheets)

- ☐ Information Disclosure Statement, PTO/SB/08A; ☐ copy of cited references
- ☐ Supplemental Information Disclosure Statement; PTO/SB/08A; copy of cited references and Check No. in the amount of \$180.00
- ☐ Associate Power of Attorney
- ☐ Petition for Extension of Time and Check No. in the amount of \$
- ☐ Petition
- ☒ Fee Transmittal Form
- ☐ Certified Copy of Priority Document(s)
- ☐ Assignment Papers (for an Application)

- ☐ Terminal Disclaimer
- ☐ Terminal Disclaimer
- ☐ Terminal Disclaimer

- ☒ Other Enclosure(s) (please identify below):

**PETITION FOR A RETROACTIVE  
LICENSE UNDER 35 U.S.C. § 184**  
with attached Declaration of  
Donald F. Hunt; Lexstat 1-I Patent  
Office Rules and Practice Rule 14

Remarks

The Commissioner is authorized to charge any additional fees required but not submitted with any document or request requiring fee payment under 37 C.F.R. §§ 1.16 and 1.17 to Deposit Account 20-1469 during pendency of this application.

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or  
Individual name

G. Scott Dorland, Ph.D.

Registration No. 51,622

Signature

Date

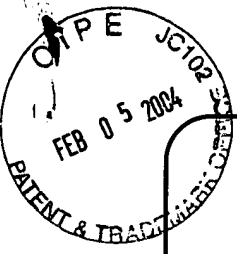
February 5, 2004

### CERTIFICATE OF MAILING

Express Mail Label Number: EV326919482US

Date of Deposit: February 5, 2004

Person Making Deposit: Christopher Haughton



# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ ) 130

## Complete if Known

Application Number	09/489,760
Filing Date	January 21, 2000
First Named Inventor	Goulmy et al.
Examiner Name	P. Huynh
Art Unit	1644
Attorney Docket No.	2183-4285US

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money ☐ Other ☐ None  
Order

☒ Deposit Account:

Deposit Account Number 20-1469

Deposit Account Name TraskBritt

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments  
☒ Charge any additional fee(s) during the pendency of this application  
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$ ) 0

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims		** =	0	X		=	0
Independent Claims		** =	0	X		=	0
Multiple Dependent				X		=	0

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ ) 0

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	130
1807	50	1807	50	Processing fee under 37 CFR 1.17 (q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) \_\_\_\_\_

\*Reduced by Basic Filing Fee Paid SUBTOTAL (3) (\$ ) 130

## SUBMITTED BY

## Complete (if applicable)

Name (Print/Type)	G. Scott Dorland, Ph.D.	Registration No. (Attorney/Agent)	51,622	Telephone	801-532-1922
Signature		Date	February 4, 2004		

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.  
If you need assistance in completing this form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.